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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1962

No. 322

ALEXANDER T. SPERRY,
Petitioner,
vs.
STATE OF FLORIDA, ex rel., THE FLORIDA BAR,
Respondent.

On Writ of Certiorari to the Supreme Court of Florida

BRIEF FOR THE PETITIONER

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BRIEF FOR THE PETITIONER

OPINION BELOW

The opinion of the Supreme Court of Florida (R. 51-68) is reported at 140 So.2d 587.

JURISDICTION

The original opinion and judgment of the Supreme Court of Florida was entered on April 4, 1962 (R. 13). A

timely petition for rehearing (R. 31) was denied on May 15, 1962 (R. 51). At that time the Court modified its opinion (R. 51) and the judgment (R. 67-68) became final. The petition for writ of certiorari was filed August 10, 1962, and was granted October 22, 1962. The jurisdiction of this Court rests on 28 U.S.C. § 1257(3).

QUESTION PRESENTED

Petitioner, a non-lawyer, has been authorized by the Commissioner of Patents to practice before the United States Patent Office. Such practice consists of representing applicants, preparing and prosecuting their applications, and advising them in that connection. Petitioner has been regularly engaged in such practice in Florida but has been enjoined by the Court below, on the ground that such practice by non-members of the Florida bar is "unauthorized" practice of law.

The question presented is whether a *state* may prohibit such Patent Office practice by federally licensed lay practitioners—limiting the right to engage in it to members of its bar—when Congress has authorized the *Commissioner* to regulate all phases of such practice and has expressly authorized him to license qualified non-lawyers therefore.

CONSTITUTIONAL PROVISIONS, STATUTES, AND REGULATIONS INVOLVED

The constitutional provisions involved are the Patent and Copyright Clause (Art. I, Sec. 8, Cl. 8), the Necessary and Proper Clause (Art. I, Sec. 8, Cl. 18), and the

Supremacy Clause (Art. VI, Cl. 2) of the Constitution of the United States. They are printed in Appendix A, p. 1, *infra.*

The statutes involved are Sections 31-33 of the Patent Act c. 950, 66 Stat. 792, 35 U.S.C. §§ 31-33. They are printed in Appendix A, pp. 1-2, *infra.*

The federal regulations involved are Rules 31, 341-348 of the Rules of Practice of the United States Patent Office in Patent Cases, 24 F.R. 10332, 37 C.F.R. §§ 1.31, 1.341-1.348. They are printed in Appendix A, pp. 2-11, *infra.*

The state regulation involved is Section 2, Article 2, of the Integration Rule of the Florida Bar, 31 F.S.A. It is printed in Appendix A, p. 11, *infra.*

STATEMENT OF THE CASE

Petitioner was admitted to practice by the United States Patent Office in 1928 and has been continuously registered for practice before it ever since (R. 8). When the present controversy arose, he maintained an office in Florida, where he actively and openly engaged in practice as a Patent Office practitioner (R. 6). That is, he held himself out as qualified to represent applicants in the Patent Office; he prepared and prosecuted patent applications; and as a necessary first step in the process, he advised potential applicants as to the patentability of their inventions (R. 7).

However, petitioner is not a member of the bar of any state, including the State of Florida (R. 6). That is true also of nearly a quarter of the nation's registered

Patent Office practitioners,[1] and of 54 of the 73 patent practitioners in Florida[2]. It is further the fact that nearly half of the patent practitioners throughout the country are not members of the bar in the states in which they practice, and that 62 of the 73 patent practitioners in Florida are not members of the Florida Bar.

The Commissioner of Patents authorizes such non-lawyers to practice pursuant to a comprehensive federal regulatory scheme, which needs a brief description at the outset for an understanding of this case. By statute, Congress has authorized the Commissioner "to prescribe regulations governing" all phases of Patent Office practice, including admission thereto and exclusion therefrom (35 U.S.C.A. §§ 31-33); and further, has expressly authorized the Commissioner to admit to practice not only attorneys, but "agents" and "other persons" as well (35 U.S.C. § 31). Accordingly, the Commissioner has prescribed detailed regulations pursuant to that broad congressional mandate (37 C.F.R. §§ 1.31, 1.341-1.348). Those

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[1]The official records of the Patent Office, maintained in accordance with the provisions of 37 C.F.R. 1.341, list 7,232 persons in the United States who are registered to represent patent applicants before the Patent Office. Of these, over 45% (3,307) are not admitted to the bar of the state in which they practice. The list breaks down as follows:

Attorneys having office addresses in states where they are members of the bar	3,925
Attorneys having office addresses in states where they are not members of the bar	1,619
Lay "Patent Attorneys" registered prior to November 15, 1938	513
Lay "Patent Agents" registered subsequent to November 15, 1938	1,175

[2]"Patent Attorneys and Agents available to represent inventors before the U. S. Patent Office", U. S. Department of Commerce, Patent Office, October 1, 1961, available from the Superintendent of Documents, U. S. Government Printing Office.

regulations expressly provide for practice by qualified non-lawyers (37 C.F.R. § 1.341(b)).

The prerequisites for admission to practice—applicable equally to lawyers and non-lawyers—are spelled out by the Patent Act and the Commissioner's regulations. Applicants for admission must be of good moral character and good repute, and must show that they possess the legal, scientific and technical qualifications required to enable them to serve patent applicants effectively in the presentation and prosecution of applications in the Patent Office (35 U.S.C. § 31; 37 C.F.R. § 1.341(c)). Additionally, applicants must pass a rigorous examination administered by the Patent Office (37 C.F.R. § 1.341(c)).

All persons who have met those requirements, whether or not they are lawyers, are "admitted to practice before the Patent Office" (37 C.F.R. § 1.341(a), (b)), and their names are enrolled on an appropriate register of practitioners who are "recognized as entitled to represent applicants before the Patent Office in the preparation and prosecution of applications for patent" (37 C.F.R. § 1.341). Their practice must conform to the extensive Patent Office Rules of Practice in Patent Cases (37 C.F.R. §§ 1.1-1.352), including the standards of professional conduct prescribed thereby (e.g., 37 C.F.R. §§ 1.344, 1.345); and failure to observe those requirements may result in disciplinary proceedings before the Patent Office, leading to suspension or exclusion from practice, subject only to review by the federal courts (35 U.S.C. § 32; 37 C.F.R. § 1.348).

The present controversy arose on February 23, 1961, when the Florida Bar instituted this action by petitioning

the Supreme Court of Florida for a rule requiring petitioner to show cause why he should not be enjoined from engaging in the unauthorized practice of law (R. 2). The Bar contended, in substance, that the activities in which petitioner was engaged are unlawful when performed by a non-lawyer of the state bar, under Section 2, Article 2, of the Integration Rule of the Florida Bar (R. 2-4).[3]

On March 6, 1961, the Court issued the requested rule to show cause (R. 5), and ten days later petitioner filed a responsive pleading (R. 6). In it, he admitted that he was engaged in the activities here in question (R. 6, 7), and alleged, by way of defense, that he was registered for such practice by the United States Patent Office (R. 8).

As there was no dispute concerning the material facts, the cause was argued and submitted on the pleadings and briefs, without the taking of testimony (R. 53).

On May 4, 1962, the Court filed an original opinion (R. 13), which, with a minor change mentioned hereafter, eventually became its final decision (R. 51). In the opinion, the Court disposed of the state law questions first, holding that for purposes of the Integration Rule, the representation of applicants before the Patent Office in the preparation and prosecution of patent applications constitutes the practice of law (R. 61-62). Then, addressing the federal question, it held that petitioner's federal license did not give him the right to engage in such practice without complying with the state's requirements for

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[3] "2. No person shall engage in any way in the practice of law in this state unless such person is an active member of the Florida Bar, in good standing * * *."

admission to law practice (R. 65); and indeed, on the contrary, that even though the Patent Office had licensed petitioner to practice before it, the state's police power permits it "to deny [him] the right to so practice" in Florida (R. 55). In other words, the Court was of the opinion that federal law did not, and could not, authorize petitioner to engage in Patent Office practice in Florida without being admitted to the Florida Bar.

Therefore, the Court enjoined petitioner from, inter alia, preparing and prosecuting applications for letters patent and amendments thereto; from holding himself out as qualified therefor; from rendering opinions as to patentability—concededly a necessary first step in representing another in securing a patent (R. 59); from describing himself as a "patent attorney" in accordance with his Patent Office registration[4]—a practice which he had voluntarily ended (R. 7). The injunction was limited, of course, to such activities within the State of Florida (R. 67).

On April 16, 1962, before the Court's decision became final, petitioner filed a timely petition for rehearing (R. 31). In it, he pointed out the squarely conflicting decision of the Ohio Court of Appeals in *Battelle Memorial Institute v. Green et al.*, 133 U.S.P.Q. 49 (unreported in the state reporter system but printed at R. 34). That case,

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[4]All persons registered with the Patent Office prior to November 15, 1938, were registered as "patent attorneys," whether they were attorneys at law or not, and such registrations have not been changed by the Patent Office. Non-lawyers admitted subsequently are registered as "patent agents." There is no differentiation between "patent attorneys" and "patent agents," however, with respect to the activities authorized by their registration (see, e.g., 37 C.F.R. §§ 1.31 and 1.341, Appendix A, pp. 2-6, *infra*).

which reversed certain trial court decisions mentioned in the original opinion below (R. 18),[5] held that the federal government had occupied the field of Patent Office practice regulation to the exclusion of the states; and that, as a consequence, the states have no power to prohibit the preparation and prosecution of patent applications by registered Patent Office practitioners, even though those practitioners are not authorized by state law to engage in the practice of law (R. 44). Petitioner therefore sought further consideration of the Court's conclusions with respect to the federal question (R. 31-34).

On May 15, 1962, the Court filed a "corrected" opinion from which references to the reversed Ohio decisions (R. 18-19) had been deleted at R. 57. With that minor modification of the Court's opinion, the petition for rehearing was denied (R. 51). The next day, the Court stayed execution and enforcement of its judgment for ninety days, to enable petitioner to seek review by this Court (R. 69).

SUMMARY OF ARGUMENT

This case involves a conflict between the power of the federal government to operate the United States Patent Office and the police power of the states to regulate the

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[5] *Battelle Memorial Institute v. Green, et al.*, 84 O.L.A. 353, 173 N.E.2d 201 (Ohio Court of Common Pleas, Franklin County, 1961); *In re Battelle Memorial Institute*, 170 N.E.2d 774 and 172 N.E.2d 917 (Ohio Court of Common Pleas, Franklin County, 1960). Also cited in the original opinion below, but deleted from the final version, was another decision which was, in effect, overruled by the Court of Appeals in the *Battelle* case: *Marshall v. New Inventors Club, Inc.*, 69 O.L.A. 578, 117 N.E.2d 737 (Ohio Court of Common Pleas, Cuyhoga County, 1953).

practice of law within the states. The conflict exists here because petitioner has been granted the right by the Commissioner of Patents, acting under authorization by Congress, to practice before the Patent Office, but respondent, the State of Florida, has denied him that right as long as he resides in Florida, because petitioner is not a member of the Florida bar. That is, Congress has determined that both attorneys and agents may be patent practitioners, but the State of Florida says that only attorneys may be patent practitioners in Florida.

Historically, both attorneys and agents have practiced in the Patent Office. Such practice has been approved by Congress as early as 1870, when Congress first referred to patent agents in the statutes. The present case is the first time that any state has ever held that patent agents could not practice before the Patent Office, i.e., that they could not represent patent applicants in the preparation and prosecution of patent applications.

The patent law (including the statutes and rules of the Patent Office) does not state specifically that the states are forbidden to regulate patent practitioners. For this reason respondent says that this silence leaves the states free to exercise their traditional police powers so that they may impose their own regulations on patent practitioners and limit practice before the Patent Office to only those patent practitioners who are members of the state bar.

However, this is a proper case where congressional intent to supersede the police power of a state should be implied, although not expressly stated. Following the criteria listed in *Rice v. Santa Fe Elevator Corporation*,

331 U.S. 218, 67 S. Ct. 1146, 91 L. Ed. 1447 (1947), supersession of state police power should be implied because: (1) the federal interest in the operation of the federal patent system is so dominant as to preclude regulation thereof by the states; (2) the scheme of federal regulation of the admission, conduct and discipline of patent practitioners is so comprehensive and pervasive as to make reasonable the inference that Congress left no room for the states to supplement it; (3) the objects of the federal regulations and the state action are precisely the same, namely, to protect the public against representation before the Patent Office by unqualified patent practitioners; and (4) the policy of Florida to exclude non-lawyer patent practitioners from practice before the Patent Office is plainly inconsistent with the objective of Congress to permit non-lawyer patent practitioners to practice.

Since the clear intent of the federal patent law is to exclude state action pertaining to the regulation of patent practitioners, and since in cases of conflict the federal power is supreme under the Constitution, then the court below exceeded its power and erred in suspending petitioner from practice before the Patent Office.

ARGUMENT

Petitioner has been duly authorized by the Commissioner of Patents, pursuant to Federal law, to represent applicants before the United States Patent Office in the preparation and prosecution of patent applications. The question involved here is whether a state has power to suspend this right.

The Court below decided that it had this power and held that petitioner should be prohibited from carrying on business as a registered patent practitioner in Florida, solely on the ground that petitioner was not a member of the Florida bar and that the state must protect its citizens from being represented in patent matters by non-lawyers.

At the outset, it must be emphasized that the only right of petitioner that is here involved is his right to practice before the Patent Office. Petitioner does not contend that he has a right to practice in any area of law regulated by the State of Florida, or that he has any right to represent persons before any agency, board, commission or Court of Florida, nor does he urge this Court to declare that he has such rights.

One of the bases for the decision of the Court below is that practice before the Patent Office does, in fact, constitute the practice of law (R. 62). Although the case law is unsettled on this particular point, we contend that it is immaterial whether Patent Office practice is considered as "a practice of law" or not. Instead, we contend that Patent Office practice is a practice (whether legal or not) which is defined by federal law and one which the federal government alone has power to regulate. More specifically, we contend that the federal government has fully occupied the field of patents and has fully legislated and ruled upon who may practice before the Patent Office and who may be suspended from practice before the Patent Office.

This complete power over practice before the Patent Office supersedes any power of a state to regulate this

practice. As a consequence, the Court below exceeded its powers and its action was, accordingly, improper.

The Court below and respondent in its brief in opposition to the petition for certiorari urge that the states have a historic right to define the practice of law, to determine who is qualified to practice within its borders and to protect their citizens from unauthorized practice.[6] As a general proposition, this is correct. However, even historic rights of states must give way if they are exercised in conflict with powers delegated to and exercised by the federal government.

> *Parker v. Brown*, 317 U.S. 341, 359, 63 S. Ct. 307, 87 L. Ed. 315 (1943)
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> "The governments of the states are sovereign within their territory save only as they are subject to the prohibitions of the Constitution or as their action in some measure conflicts with powers delegated to the National Government, or with Congressional legislation enacted in the exercise of those powers. * * *"[11]

Although the state statute here involved[7] is not contrary on its face to the proper exercise of a federal power in that there is no provision that patent practitioners are to be excluded from practice in Florida if they are not members of the Florida Bar, nevertheless, the application of this statute by the Supreme Court of Florida to petitioner places it in direct conflict with the federal patent laws. It is, however, unimportant that the State of Florida has acted through its judicial branch,

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[6]R. 65; "Brief in Opposition to Petition for Writ of Certiorari to the Supreme Court of Florida", pp. 6 and 7.

[7]Section 2, Article 2, of the Integration Rule of the Florida Bar, 31 F.S.A., printed in Appendix A, p. 11, *infra*.

rather than through its legislative branch, since the action of the Court below is still an exercise of state power that must be scrutinized by this Court."

As indicated by the dissenting opinion of Justice Burton in *People of State of California v. Zook*, 336 U.S. 725, 749, 69 S. Ct. 841, 852, 93 L.Ed. 1005 (1949), we should not consider merely the historic rights of a state, but should also look to the nature of the federal power involved:

> "We start not merely with the inherent right of a state to exercise its police power over acts within its jurisdiction. We start also with the constitutional provisions by which the supreme legislative power of the respective states has been delegated to Congress to regulate interstate commerce.
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> Once Congress has lawfully exercised its legislative supremacy in one of its allotted fields and has not accompanied that exercise with an indication of its consent to share it with the states, the burden of overcoming the supremacy of the federal law in that field is upon any state seeking to do so."

THE HISTORICAL BACKGROUND OF THE FEDERAL PATENT SYSTEM DEMONSTRATES THE LONG-CONTINUED PURPOSE OF CONGRESS TO PERMIT BOTH AGENTS AND ATTORNEYS TO PRACTICE BEFORE THE PATENT OFFICE AND ALSO DEMONSTRATES THE INTENTION OF CONGRESS TO REGULATE FULLY THE ADMISSION, CONDUCT AND SUSPENSION OF PATENT PRACTITIONERS.

The Constitution of the United States, Art. 1, §§ 8 and 18, confers upon Congress the power "to promote the

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"*National Ass'n. of A. of C. P. v. State of Alabama*, 357 U.S. 449, 463, 78 S. Ct. 1163, 1172, 2 L. Ed. 2d 1488 (1958).

progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries" and "to make all laws which shall be necessary and proper for carrying into execution the foregoing powers and all other powers vested by this Constitution in the Government of the United States."

The first statute on the subject of patents—Act of 1790, c. 7, 1 Stat. 109, §§ 1-7—authorized the issuance of patents by the Secretary of State, the Secretary for the Department of War, and the Attorney General, or any two of them, "if they shall deem the invention or discovery sufficiently useful and important." The Patent Act of 1793, c. 11, Stat. 318, which next followed authorized patents to be issued by the Secretary of State upon the certificate of the Attorney General that they are conformable to the act.

This continued to be the law until the passage of the Act of 1836, c. 357, 5 Stat. 117, §§ 1-21, at which time the Patent Office was created, the chief officer of which was designated as the Commissioner of Patents.

In 1870, the patent law was completely revised, c. 230, 16 Stat. 198, §§ 1-111. Since patent applicants had long been represented in the Patent Office by attorneys in fact, Congress recognized this in providing: "That for gross misconduct the Commissioner may refuse to recognize any person as a patent . . .",[9] and "That, when the nature of the case admits of drawings, the applicant shall furnish

[9]Act of 1870, c. 230, 16 Stat. 198, § 17.

one copy signed by the inventor of his attorney in fact . . ."[10]

In *Hoosier Drill Co. v. Ingels*, 15 O.G. 1013 (1879), the court stated that: "The law seems to prescribe no qualifications, either of capacity, character, age, sex, or citizenship, or of any other kind, for patent agents." It was declared in *Osgood v. Badger*, 44 O.G. 1065 (1884), that patent attorneys are not required to be learned lawyers.

In one of the early texts on patent law, *Robinson on Patents*, Little, Brown and Company (1890), it was stated (at p. 15, Vol. II):

> "An inventor may choose any person of intelligence and good moral character to act as his attorney in the prosecution of his application for patent. Over all such attorneys, the Commissioner of Patents has a certain authority and he may pass upon appointments and dismissals."

Pursuant to the authority granted to him in the Patent Act of 1870 to adopt rules regulating Patent Office proceedings,[11] the Commissioner from time to time promulgated rules governing the recognition of both attorneys and agents as patent practitioners.[12]

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[10] Ibid: § 27.

[11] Act of 1870, c. 230, 16 Stat. 198, § 19.

[12] Typical of these rules are the following two rules of 1907, reprinted in *Hopkins on Patents*, Callaghan & Company, (1911) at pp. 1322-1325:

> "Rules of Practice in the United States Patent Office. Revised July 17, 1907.
>
> • • •
>
> "17. A register of attorneys will be kept in this office, on which will be entered the names of all persons entitled to represent applicants before the Patent Office in the presentation and prosecution of applications for patent. The names of

In 1922, as a recognition of the existing practice, Congress specifically authorized the Commissioner of Patents to recognize both attorneys and non-attorneys to represent patent applicants.[13] In this act, Congress treated attorneys and non-attorneys as equals, ending the automatic registration of attorneys in the Patent Office, and allowing the Commissioner to require members of either group to show that they had the necessary qualifications

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persons in the following classes will, upon their written request, be entered upon this register.

(a) Any attorney at law who is in good standing in any court of record in the United States or of any of the States or Territories thereof and shall furnish a certificate of the clerk of such United States, State or Territorial court, duly authenticated under the seal of the court, that he is an attorney in good standing.

(b) Any person not an attorney at law who shall file proof to the satisfaction of the Commissioner that such person is of good moral character and of good repute and possessed of the necessary qualifications to enable him to render applicants for patent valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office."

• • •

"22 (e). For gross misconduct the Commissioner may refuse to recognize any person as a patent agent, either generally or in any particular case, but the reasons for such refusal will be duly recorded and be subject to the approval of the Secretary of the Interior."

[13] Patent Act of 1922, c. 58, 42 Stat. 390, § 3:

"The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may prescribe rules and regulations governing the recognition of agents, attorneys or other persons representing applicants or other parties before his office, and may require of such persons, agents, or attorneys, before being recognized as representatives of applicants or other persons, that they show that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and are likewise competent to advise and assist applicants or other persons in the presentation or prosecution of their applications or other business before the office . . ."

to enable them to advise clients and to prepare and prosecute patent applications in the Patent Office.

By the same act, Congress vested the Commissioner with power to discipline both patent attorney and agent practitioners. The provisions apply with equal force to both attorneys and non-attorneys.[14]

In 1934, the Commissioner of Patents issued an order[15] requiring all persons (whether attorneys or non-attorneys) desiring to be registered as a patent attorney to take an examination in order to establish that they have the requisite legal and scientific knowledge to qualify them to render service as patent attorneys.[16]

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[14] Patent Act of 1922, c. 58, 42 Stat. 390, § 3:

"... and the Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before his office any person, agent or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the said rules and regulations, or who shall with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the office, by word, circular, letter or advertising. The reasons for any such suspension or exclusion shall be duly recorded, and the action of the Commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the Supreme Court of the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine."

[15] Commissioner's Order No. 3266, March 12, 1934, 440 O.G. 781.

[16] It has been held, *Caples v. Marzall*, 101 F. Supp. 579, (D.C., D.C., 1952), affirmed 204 F. 2d 58, that the Commissioner has the authority and duty to require an examination to ascertain the qualifications of applicants for admission to practice before the Patent Office and the power to reject applicants who fail to pass such an examination. The Court briefly described the scope of this examination:

"The first part of the examination consisted of thirty-five questions as to law and practice, and the second part six questions designed to test the applicant's knowledge of the preparation of apparatus and process claims. • • •"

The patent laws were next revised in 1952, when Congress passed the current Patent Act of 1952, c. 950, 66 Stat. 792, §§ 1-293. Again Congress authorized the Commissioner of Patents to "prescribe regulations governing the recognition and conduct of agents, attorneys or other persons representing applicants or other parties before the Patent Office."[17] The Commissioner of Patents was further authorized to "require them, before being recognized as representatives of applicant or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicant or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office."[18]

Congress also vested in the Commissioner of Patents the power to suspend or exclude from further practice before the Patent Office any person, agent or attorney for various enumerated offenses. The United States District Court for the District of Columbia was given power to review the action of the Commissioner.[19]

Congress further manifested its intent that the Commissioner should have exclusive authority over patent practitioners by making it an offense for a person to hold himself out as qualified to prepare or prosecute patent applications without being recognized by the Commissioner to practice before the Patent Office.[20]

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[17] 35 U.S.C. 31.
[18] Ibid.
[19] 35 U.S.C. 32.
[20] 35 U.S.C. 33.

Pursuant to the authority vested in him, the Commissioner has prescribed comprehensive rules governing the recognition of patent practitioners.[21] These rules, of course, have the effect of law.[22] A patent applicant may be represented by an "agent authorized to practice before the Patent Office in patent cases."[23] Any person desiring to be authorized to practice before the Patent Office, whether attorney or agent, must "establish to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the legal and scientific and technical qualifications necessary to enable him to render applicants for patents valuable services, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office."[24] All prospective practitioners, whether attorneys or agents, are required to take and pass an examination.[25]

Patent practitioners, whether attorneys or agent, "must conform to the standards of ethical and professional con-

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[21]37 C.F.R. 1.31, 1.341-1.348.

[22]*United States ex rel. Steinmetz v. Allen*, 192 U.S. 543, 24 S. Ct. 416, 419, 48 L. Ed. 555 (1904).

"By § 483 of the Revised Statutes (U.S. Comp. Stat. 1901, p. 272), the Commissioner of Patents, subject to the approval of the Secretary of the Interior, is empowered to establish from time to time regulations not inconsistent with law, for the conduct of proceedings in the Patent Office. The Commissioner of Patents, exercising the power conferred, established, among other rules of practice, rule 41. It thereby became a rule of procedure, and constituted, in part, the powers of the primary examiner and Commissioner. In other words, it became an authority to those officers, and, necessarily, an authority 'Under the United States.' * * *"

[23]37 C.F.R. 1.31.

[24]37 C.F.R. 1.341(c).

[25]Ibid.

duct generally applicable to attorneys before the Courts of the United States."[26]

Under the rules of the Patent Office, the Commissioner is given exclusive power to discipline patent practitioners. "Except as otherwise provided, proceedings for suspension, disbarment, or exclusion from practice are before a Commissioner."[27] "The duties of investigation, preparing charges, collecting and presenting testimony, and presenting a case for suspension, exclusion from practice or disbarment shall be performed by the Solicitor of the Patent Office."[28] "Proceeding for suspension or disbarment shall be instituted by the Solicitor."[29] The Commissioner "will set the case for hearing before him."[30] "Proceedings shall be governed, in matters not specifically set forth herein, by the provisions of the Administrative Procedure Act, 60 Stat. 237; 5 U.S.C. 1001-1011, which may be applicable."[31]

The operation of the Patent Office is plainly national in scope. There is a single Patent Office, located in Washington, D.C.; there are no branch offices located throughout the states. Except for occasional visits by patent practitioners to the Patent Office to discuss particular applications with the patent examiners or to argue appeals, motions and interferences, the great bulk of patent practice is carried on by mail. Indeed, Rule 2 of the Patent

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[26] 37 C.F.R. 1.344.
[27] 37 C.F.R. 1.348.
[28] 37 C.F.R. 1.348(a).
[29] 37 C.F.R. 1.348(b).
[30] 37 C.F.R. 1.348(d).
[31] 37 C.F.R. 1.348(f).

Office provides that "all business with the Patent Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent Office is unnecessary."[32] On this account, patent practitioners and agents reside throughout the United States, where they may be near their clients. The geographical scattering of patent practitioners may be best illustrated from the fact that patent practitioners reside and practice in forty-eight of the fifty states (all save Alaska and North Dakota) and in the District of Columbia.[33] As of January 23, 1962, 7,232 patent practitioners were registered by the Patent Office, 3,925 of whom are attorneys of the state where they practice and 3,307 of whom are not members of the bar where they practice.[34]

Regardless of where they practice, or whether they are attorneys or agents, all patent practitioners must practice before the Patent Office in accordance with the one set of rules established by the Commissioner. These rules are completely uniform in application throughout the country. There are no provisions whatsoever for local exceptions to the rules based upon particular or peculiar circumstances existing in any city, state, region or area of the country, nor is there any authority delegated by Congress or the Commissioner to any political subdivision of the United States to make any local regulations concerning practice before the Patent Office.

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[32]37 C.F.R. 1.2.

[33]"Patent Attorneys and Agents available to represent inventors before the U. S. Patent Office", U. S. Department of Commerce, Patent Office, October 1, 1961, available from the Superintendent of Document, U. S. Government Printing Office.

[34]See footnote 1, supra.

As is apparent from the above discussed Patent Act of 1952 and the rules of practice of the Patent Office, practice before the Patent Office, skill in engineering and scientific matters and familiarity with patent procedures are just as necessary as skill in legal matters.

The mixed quality of this skill has long been recognized by this Court. In discussing the problems involved in the grant of a patent by the Patent Office, this Court stated in *Butterworth v. United States*, 112 U.S. 50, 5 S. Ct. 25, 29, 28 L.Ed. 656 (1884):

> "• • • The questions of fact arising in this field find their answers in every department of physical science, in every branch of mechanical art. The questions of law necessary to be applied in the settlement of this class of public and private rights have found a special branch of technical jurisprudence. The investigation of every claim presented involves the adjudication of disputed questions of facts, upon scientific or legal principles, and is, therefore, essentially judicial in its character, and requires the intelligent judgment of a trained body of skilled officials, expert in the various branches of science and art, learned in the history of invention, and proceeding by fixed rules to systematic conclusions."

To summarize the historical development of practice before the Patent Office, it has long been recognized that specialized technical skills are necessary to prepare and prosecute patent applications. Additionally, applicants for patents have traditionally been represented in the Patent Office by both attorneys and agents.

Since 1870, Congress has recognized this representation of patent applicants by agents and has given the

Commissioner of Patents power over the admission and exclusion of patent agents to and from practice before the Patent Office. This power was rather general in nature in the beginning, but it has become more and more specific as the years have passed. At the present time, it is plain that the Commissioner has sole and exclusive power to admit attorneys and agents to practice and the sole and exclusive power to exclude attorneys or agents from practice.

It has further been recognized by this Court that the responsibility of protecting the public from unqualified patent practitioners rests in the Commissioner of Patents.

> *Kingsland v. Dorsey*, 338 U.S. 318, 319, 70 S. Ct. 123, 124, 94 L.Ed. 123 (1950).
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> "* * * It was the Commissioner, not the courts, that Congress made primarily responsible for protecting the public from the evil consequences that might result if practitioners should betray their high trust. * * *"

THE COURT BELOW IMPROPERLY HELD THAT THE HISTORIC POLICE POWER OF A STATE GIVES IT POWER TO REGULATE FEDERAL PATENT PRACTITIONERS.

In spite of the historic background of practice before the Patent Office by both attorneys and agents, the Court below held that it had the power to exclude petitioner from practice before the Patent Office, maintaining that the historic right of a state to control the practice of law gives a state the right to insist that only members of its bar may represent patent applicants in the Patent

Office.[35] The Court below stated that its decision was not to be construed to affect petitioner's right to practice before the Patent Office when done outside of Florida,[36] but, nevertheless, the plain effect of the decision is to exclude petitioner from such practice while he resides in Florida.

In support of its decision, the Court below stated that there was "no provision in the Federal Constitution or statutes for that matter, that gives to any Federal body the power to determine who may practice law in the several states."[37]

Respondent in its brief in opposition to the Petition for Writ of Certiorari restates this position by recognizing that "there is no doubt that Congress, in the exercise of power delegated to it, may and can suspend, supersede or set aside any state law in conflict with the purpose and intent of Congress."[38] Respondent continues by saying that "such purpose must be clearly manifested."[39]

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[35]It is to be noted, however, that although non-lawyer patent agents have practiced throughout the country for many, many years that no state, prior to the decision of the Court below, has ever held that the "historic right of a state to control the practice of law" entitles a state to prevent a recognized patent practitioner from practicing before the Patent Office.

[36]R. 68.

[37]R. 65.

[38]"Brief in Opposition to Petition for Writ of Certiorari to the Supreme Court of Florida," p. 8.

[39]Ibid., p. 8.

This general rule that federal law shall not by mere implication be construed to supersede the exercise of the police powers of a state is expressed in the decisions of this Court cited by respondent at pages 9-11 of its brief, i.e., *Penn Dairies v. Milk Control Com-*

Respondent then argues that the patent law does not specifically forbid the states from regulating persons who desire to practice before the Patent Office and that, therefore, the states are free to regulate in this area. In other words, respondent takes the position that the purpose and intent of Congress to exclude state action can be manifested only if Congress specifically forbids the states to act in areas even which Congress may act.

This position is incorrect. Of course, the clearest manifestation of Congressional intent to exclude state action is found when Congress states that a state may not act. However, it has long been the law that once Congress has acted in a specific area over which it has power, this action is an expression of intent to exclude state action in the same area.

> *Prigg v. Commonwealth of Pennsylvania*, 16 Pet. 539, 617, 10 L.Ed 1060, 1090 (1842).
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> "* * * it would seem, upon just principles of construction, that the legislation of Congress, if constitutional, must supersede all State Legislation upon the same subject; and by necessary implication prohibit it. For, if Congress have a constitutional power to regulate a particular subject, and they do actually regulate it in a given manner, and in a certain form, it cannot be that the State Legislatures have a right to interfere, and, as it were, by way of complement to the legislation of Congress, to prescribe additional regulations, and what they may deem auxiliary provisions for the same purpose. In such a case, the

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mission, 318 U.S. 261, 63 S.Ct. 617, 87 L.Ed. 748 (1943), *People of State of California v. Zook*, 336 U.S. 725, 69 S.Ct. 841, 93 L.Ed. 1005 (1949) and *Schwartz v. State of Texas*, 344 U.S. 199, 73 S.Ct. 232, 97 L.Ed. 231 (1952).

> legislation of Congress, in what it does prescribe, manifestly indicates that it does not intend that there shall be any further legislation to act upon the subject matter. Its silence as to what it does not do is as expressive of what its intention is as the direct provisions made by it. This doctrine was fully recognized by this court in the case of *Houston v. Moore*, 5 Wheat. Rep. 1, 21, 22, where it was expressly held that where Congress have exercised a power over a particular subject given them by the Constitution, it is not competent for State legislation to add to the provisions of Congress upon that subject; for that the will of Congress upon the whole subject is as clearly established by what it had not declared as by what it has expressed."

Thus, contrary to respondent's contention that Congressional intent must be express to be manifest, it is plain that such intent may be implied in proper cases.

> *Bethlehem Steel Co. v. New York State Labor Rel. Bd.*, 330 U.S. 767, 772, 67 S. Ct. 1026, 1029, 91 L.Ed. 1234 (1946).
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> "* * * It long has been the rule that exclusion of state action may be implied from the nature of the legislation and the subject matter although express declaration of such result is wanting." * * *"

THE PRESENT CASE IS ONE IN WHICH IT SHOULD BE CLEARLY IMPLIED THAT CONGRESS INTENDED THE STATES TO BE PRECLUDED FROM IMPOSING THEIR REGULATIONS ON PATENT PRACTITIONERS.

This Court has laid down in *Rice v. Santa Fe Elevator Corporation*, 331 U.S. 218, 230, 67 S. Ct. 1146, 1152, 86 L.Ed. 754 (1942), the factors which should be considered

in determining whether Congressional intent to supersede the police power of a state should be implied absent an express declaration of this result. Supersession of the police power of a state may be implied when:

1) The Act of Congress touches a field in which the federal interest is so dominant that the federal system will be assumed to preclude enforcement of state laws on the same subject;

2) The scheme of federal regulations is so pervasive as to make reasonable the inference that Congress left no room for the states to supplement it.

3) The object sought to be obtained by the federal law and the state action is the same; and

4) The state policy may produce a result inconsistent with the objective of the federal law.

A consideration of each of these factors will show plainly that it was the intent of Congress to prevent the State of Florida from excluding petitioner from practicing before the Patent Office.

The Federal Interest in the Patent System Is So Paramount That It Should Be Assumed That State Action Pertaining Thereto Is Precluded.

All power as to patents has been delegated to Congress by Art. I, Sec. 8 of the Constitution. It has been held by this Court that this power is plenary.

> *McClurg v. Kingsland*, 1 How. 202, 206, 11 L.Ed. 102, 103 (1843).
>
> "* * * the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution, and as there are no restraints on

its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents."

There is one patent system in this country; the states do not have a reserved power to establish their own patent systems, nor does any state maintain such a system. The federal patent system is uniform throughout the states, and there is no local variation as to the practice involved in obtaining a patent from the Patent Office. Thus, of the four classes of power in this country, it is apparent that this power as to patents belongs exclusively to the national government.

Ex parte McNeil, 13 Wall. 236, 240, 20 L.Ed. 624, 625 (1872).

"* * * In the complex system of polity which prevails in this country the powers of government may be divided into four classes:

Those which belong exclusively to the states.

Those which belong exclusively to the national government.

Those which may be exercised concurrently and independently by both.

Those which may be exercised by the states, but only until Congress shall see fit to act upon the subject. The authority of the state then retires and lies in abeyance until the occasion for its exercise shall recur.

The commercial power lodged by the Constitution in Congress is, in part, of this character. Some of the rules prescribed in the exercise of that power must, from the nature of things, be uniform through-

> out the country. To that extent the power itself must, necessarily, be exclusive; as much so as if it had been so declared to be, by the organic law, in express terms. Others may well vary with the varying circumstances of different localities. In the latter contingency the states may prescribe the rules to be observed until Congress shall supersede them; the Constitution and laws of the United States in such case, as in all others to which they apply, being the supreme law of the land. * * *"

Contrary, then, to respondent's position that state action can only be forbidden if Congress expressly so states, the position is actually reversed. That is, in instances, as here, where the power involved is exclusive with the national government, then the state may act only if expressly permitted to do so by Congress.

> *Spector Motor Service v. O'Connor*, 340 U.S. 602, 608, 71 S. Ct. 508, 511, 95 L.Ed. 573 (1951).
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> "* * * the Constitutional separation of the federal and state powers makes it essential that no state be permitted to exercise, without authority from Congress, those functions which it has delegated exclusively to Congress. * * *"

Therefore, since Congress has not specifically authorized the states to regulate practice before the Patent Office, then the states do not have any power to determine who is and who is not entitled to represent patent applicants before the Patent Office.

The Commissioner of Patents knows full well how to draft rules that will permit the states to regulate the activities of a trademark practitioner. The Commissioner

of Patents is authorized by Sec. 41 of the Trademark Act of 1946, c. 540, 60 Stat. 427, 15 U.S.C. 1123, to regulate the conduct of proceedings in the Patent Office in connection with trademark application,[40] and has adopted 37 C.F.R. 2.12 (Rules of Practice of the Patent Office in Trademark Cases), wherein attorneys and certain non-attorneys may represent trademark applicants. In this instance, however, 37 C.F.R. 2.12 provides that:

> "(d) Recognition of any person under this section is not to be construed as sanctioning or authorizing the performance of any acts in the jurisdiction when performed as the unauthorized practice of law."

There is no corresponding provision in the Rules of Practice of the United States Patent Office in Patent Cases which would permit state control over patent practitioners.

Since the rules of the Patent Office expressly permit the states to regulate trademark practitioners, but are completely silent as to state control of patent practitioners, then it is obvious that the rules do not contemplate or permit any state regulation of patent practitioners.

Further illustrating the dominance and exclusiveness of the federal interest involved is the fact that the action of the State of Florida was taken solely because Congress

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[40]The power of the Commissioner of Patents to regulate the federal trademark system comes not from the patent clause (Art. 1, § 8, cl. 8) but from the commerce clause (Art. 1, § 8, cl. 3). *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 98, 39 S. Ct. 48, 51, 63 L.Ed. 141 (1918). Under the commerce clause there is concurrent power in the states and the national government relating to trademarks, with the power of the national government being restricted to trademarks used in interstate commerce.

had acted in this field. For example, suppose that Congress had never established a patent system pursuant to its power to do so. Then, there would be no Patent Office and no practice of preparing and prosecuting patent applications. Obviously, there would be no reason or need for a state to contend it could regulate such a nonexistent practice. It is only because Congress has specifically established a Patent Office and because Congress has specifically authorized qualified laymen to practice before the Office that a supposed evil has arisen for the State of Florida to correct.

The Scheme of Federal Regulations of Patent Practitioners Is So Comprehensive and Pervasive as to Leave No Room for the States to Modify or Supplement It.

Even if it were assumed, for the sake of argument, that the power to regulate patent practitioners was not exclusive with the federal government, but was a power to be exercised concurrently by the federal government and the states, still it is clear that the federal government has so occupied the field as to preclude state regulation.

Of course, in situations where concurrent federal and state power exists, it is possible for a state to act in areas in which the federal government has not acted.

> *Atchison, T. & S.F. Ry. Co. v. Railroad Commission*, 283 U.S. 380, 392, 51 S. Ct. 553, 556, 75 L. Ed. 1128 (1931).
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> "• • • The principle thus applicable has been frequently stated. It is that the Congress may circumscribe its regulation and occupy a limited field and that the intention to supersede the exercise by the

> state of its authority as to matters not covered by the federal legislation is not to be implied unless the Act of Congress fairly interpreted is in conflict with the law of the State. * * *"

However, that is not the situation here, because Congress, and the Commissioner of Patents under authorization of Congress, have specifically and comprehensively acted in the precise area in which respondent seeks to act.

As brought out previously, Congress has specifically authorized the Commissioner of Patents to allow both attorneys and non-attorneys to represent patent applicants before the Patent Office, and has specifically authorized the Commissioner of Patents to suspend or exclude both attorneys and non-attorneys from such practice.[41] Pursuant to this authority, the Commissioner has adopted detailed regulations concerning admission to practice, conduct and suspension or exclusion from practice.[42]

The statutes and regulations governing admission to and exclusion from practice are mandatory in nature. Rule 343 provides that no person, not recognized by the Commissioner, "will be permitted to prosecute application of others before the Patent Office."[43] It is an offense, punishable by a fine of not more than $1,000.00 to hold oneself out as qualified to prepare or prosecute applications for patent if not recognized by the Commissioner.[44] Clearly, there is no power in a state, in the first instance, to designate who is to practice before the Patent Office.

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[41] 35 U.S.C. 31, 32.
[42] 37 C.F.R. 1.341-1.348.
[43] 37 C.F.R. 1.343.
[44] 35 U.S.C. 33.

No matter how qualified a state may think a person to be, that person cannot practice before the Patent Office without being admitted to the Patent Office by the Commissioner.

Similarly, the power to exclude patent practitioners from practice before the Patent Office, once so recognized, is vested solely in the Commissioner: "Proceedings for suspension, disbarment, or exclusion from practice *are* before a Commissioner." "Proceedings for suspension or disbarment *shall* be instituted by the Solicitor" of the Patent Office, the Commissioner "*will* set the hearing before him.[45] (Emphasis added). The mandatory nature of these provisions makes it clear that all power in this area is lodged in the Commissioner and that the states have no power to suspend or exclude a recognized patent practitioner from practice before the Patent Office.[46]

Therefore, since the federal government has exercised its power over the admission, conduct and suspension of patent practitioners, then respondent is without power to also act in this particular area.

> *Pennsylvania R. Co. v. Public Service Commission*, 250 U.S. 566, 569, 40 S. Ct. 36, 37, 64 L.Ed. 1142 (1919):
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> "* * * But when the United States has exercised its exclusive powers over interstate commerce so far as to take possession of the field, the States no more

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[45]37 C.F.R. 1.348.

[46]Respondent, of course, did not follow any of the procedure outlined in 37 C.F.R. 1.348 when it acted to suspend petitioner from practicing before the Patent Office while residing in Florida, but instead acted solely under color of state law on the subject.

can supplement its requirements than they can annul them. * * *"

Supersession of State Police Power Should Be Implied Here Because the Object of the Congressional Legislature Is Precisely the Same as the Aim of the State Action in Question.

This is the third factor mentioned in *Rice v. Santa Fe Elevator Corporation*, 331 U.S. 218, 230, 67 S. Ct. 1146, 1152, 86 L.Ed. 754 (1942), for consideration. If Congress and the states are both seeking to correct the same evil, then the Congressional enactment will supersede state action thereon.

The intent of Congress in the regulation of patent practitioners has been clearly expressed by this Court in *Kingsland v. Dorsey*, 338 U.S. 318, 319, 70 S. Ct. 123, 124, 94 L.Ed. 123 (1950), as follows:

> "* * * It was the Commissioner, not the courts, that Congress made primarily responsible for protecting the evil consequences that might result if practitioners should betray their high trust. * * *"

Obviously, this is the same purpose that the Court below had in mind when it excluded petitioner from practicing before the Patent Office:

> "The reason for prohibiting the practice of law by those who have not been examined and found qualified to practice is * * * done to protect the public from being advised and represented in legal matters by unqualified persons on whom the judicial department can exercise little, if any, control in the matter of infraction of the code of conduct which, in the public interest, lawyers are bound to observe."[47]

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[47] R. 65.

Clearly, there is not only an overlap, but a full coincidence, of federal and state purpose. Since the federal government has enacted full and comprehensive statutes and regulations to achieve this purpose, then the supersession of state power to achieve the same purpose should be implied.

The present situation is plainly different from the recent decision of this Court in *Huron Portland Cement Co. v. City of Detroit, Michigan*, 362 U.S. 440, 80 S. Ct. 813, 4 L.Ed. 2d 852 (1960), wherein federal legislation and a state ordinance, both governing boat equipment, were involved and wherein the state ordinance was upheld because the objects sought to be achieved by federal and state action were different and of non-overlapping scope.

Supersession of State Police Power Should Be Implied Here Because the State Action Is in Direct Conflict With the Objective of the Federal Laws Concerning Patent Practitioners.

By the mere fact that Congress has authorized the Commissioner of Patents to permit patent applicants to be represented in the Patent Office by patent agents, it is, of course, apparent that Congress deems it advisable that non-lawyers be permitted to practice before the Patent Office.[48] The action taken by the State of Florida is in direct conflict with this objective.

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[48]Respondent at pages 13 and 14 of its brief in opposition to the Petition for Writ of Certiorari, suggests that Congress did not have any objective of providing for a class of non-lawyer patent practitioners nor that such a class is at all essential to the functioning of the Patent Office, since 35 U.S.C. 31 is merely permissive in authorizing the Commissioner of Patents to recognize patent agents. This position seems impossible to support in view of the historical representation of patent applicants by patent agents, a

Petitioner has shown the Commissioner of Patents that he is properly qualified to practice before the Patent Office as a patent agent, and he has been authorized by the Commissioner to "advise and assist" applicants for patent "in preparation and prosecution of their applications before the Patent Office."

The Court below specifically enjoined petitioner from "holding himself out, in this state, as qualified to prepare and prosecute applications for letters patent, and amendments, thereto," and from the "preparation and prosecution of applications for letters patent, and amendments, thereto, in this state,"[49] merely because he was not a member of the Florida Bar. The effect of this decision is that Florida simply does not deem it advisable that non-lawyers be permitted to practice before the Patent Office, regardless of their qualifications to do so.[50]

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fact well known to Congress for many, many years, and the fact that over 45% of the patent practitioners currently recognized by the Commissioner are not members of the bar of the states in which they practice. Also, it is plain that this number of patent agents is necessary for continued orderly administration of the patent system. There are currently over 190,000 patent applications pending in the Patent Office. If nearly half of the patent practitioners were suddenly eliminated, the confusion and chaos in the Patent Office would be incalculable. By analogy, respondent would have to take the position that the functioning of the Florida courts would be unaffected if half of the Florida lawyers were suddenly barred from practice. This surely would not be so in Florida; it likewise is not so in the Patent Office.

[49]R. 68.

[50]This is emphasized by the fact that the Court below was not concerned with whether petitioner was a capable patent practitioner or not, as noted by the following remarks (R. 66):

> "In fairness to the respondent in this cause, we make clear that nothing we say in this opinion is intended to indicate that he is not in fact competent to perform those services which he has rendered or that the affairs of any citizen of this state have suffered at his hands."

The Court below attempts to soften the effect of its decision by saying that petitioner can practice before the Patent Office if he moves to another state. Yet, if Florida has the power to eliminate patent agents, then any other state to which petitioner might move would have the same power and could again prevent him from practicing before the Patent Office. If all states followed the lead of respondent, they would totally eliminate the congressionally authorized class of patent agents by denying them a place to practice. The objective of Congress in providing for the representation of patent applicants by qualified patent agents would be completely frustrated.

It follows then that the action of the State of Florida is manifestly improper.

> *Hill v. State of Florida*, 325 U.S. 538, 542, 65 S.Ct. 1373, 1375, 89 L.Ed. 1782 (1945).
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> "Thus, the 'full freedom' of employees in collective bargaining which Congress envisioned as essential to protect the free flow of commerce among the states would be, by the Florida statute, shrunk to a greatly limited freedom. No elaboration seems required to demonstrate that Section 4 as applied here 'stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.' Hines v. Davidowitz, 312 U.S. 52, 67, 61 S.Ct. 399, 404, 85 L.Ed. 581; Cloverleaf Butter Co. v. Patterson, 315 U.S. 148, 62 S.Ct. 491, 86 L.Ed. 754; Napier v. Atlantic Coast Line R. Co., 272 U.S. 605, 47 S.Ct. 207, 71 L.Ed. 432. • • •"

The rationale of this Court in *Leslie Miller, Inc. v. State of Arkansas*, 352 U.S. 187, 77 S.Ct. 257, 1 L.Ed.2d 231 (1956), should be followed in the present case to re-

verse the decision of the Court below. In the *Miller* case, a contractor was awarded a bid to construct an air force base in Arkansas for the federal government after satisfying the federal government that he was a responsible contractor. The State of Arkansas then prosecuted and convicted the contractor for not having obtained a license for such activity from the state. This Court reversed the conviction, saying at 352 U.S. 189:

> "Mere enumeration of the similar grounds for licensing under the state statute and for finding 'responsibility' under the federal statute and regulations is sufficient to indicate conflict between this license requirement which Arkansas places on a federal contractor and the action which Congress and the Department of Defense have taken to insure the reliability of persons and companies contracting with the Federal Government. Subjecting a federal contractor to the Arkansas contractor license requirements would give the State's licensing board a virtual power of review over the federal determination of 'responsibility' and would thus frustrate the expressed federal policy of selecting the lowest responsible bidder.* * *"

The situation here is parallel. The Commissioner of Patents has decided that petitioner is qualified to represent patent applicants before the Patent Office, but the State of Florida insists that petitioner must join the Florida Bar before he can practice, not in any matter of state law, but before the United States Patent Office. This Court reversed the conviction by Arkansas of the federal contractor in the *Hill* case. It should, likewise, reverse the suspension by Florida of petitioner, a federal patent practitioner.

On the basis of the above considerations it is clear that: Congress has exclusive power over patent matters; Congress has specifically provided for patent agents; it is the intent of Congress to vest the Commissioner of Patents with the duty of protecting the public from improper representation before the Patent Office; and the Commissioner has adopted comprehensive regulations concerning the admission, conduct and discipline of patent practitioners to carry out this objective. In view of this, it is manifest that Congress intended to exclude the states from regulating patent practitioners.

As a consequence, the Court below clearly exceeded its power.

CONCLUSION

For the foregoing reasons, the decision of the Court below should be reversed to permit petitioner to continue in Florida "to represent applicants before the Patent Office in the preparation and prosecution of applications," a right granted to him under 37 C.F.R. 1.341 by the Commissioner of Patents acting under the authorization of Congress.

Dated, San Francisco, California,
December 17, 1962.

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(Appendix A Follows)

Appendix A

Constitution of the United States

Art. I, Sec. 8, cl. 8. The Congress shall have power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Art. I, Sec. 8, cl. 18. The Congress shall have Power . . . To make all Laws which shall be necessary and proper for carrying into Execution the foregoing Powers, and all other Powers vested by this Constitution in the Government of the United States, or in any Department or Officer thereof.

Art. VI, cl. 2. This Constitution, and the Laws of the United States which shall be made in Pursuance thereof and all treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, anything in the Constitution or Laws of any State to the contrary notwithstanding.

Patent Act of 1952, c. 950, 66 Stat. 792, §§ 31-33, 35 U.S.C. §§ 31-33.

§ 31. The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character

699, and adopted certain principles, including the following:

> "(a) The Florida Bar, a body created by and existing under the authority of this Court, is charged with the maintenance of the highest standards and obligations of the profession of law, and to that end is vested by this Court, in the exercise of its inherent powers over The Florida Bar as an official arm of this Court, with the necessary powers and authority."

Article II of the Integration Rule provides as follows:

> "2. No person shall engage in any way in the practice of law in this state unless such person is an active member of The Florida Bar in good standing except that a practicing attorney of another state, in good standing, who has professional business in a court of record of this state may, upon motion, be permitted to practice for the purpose of such business only, when it is made to appear that he has associated and appearing with him in such business an active member of The Florida Bar."

Article V, Section 23 of the Constitution of the State of Florida provides as follows:

> "The Supreme Court shall have exclusive jurisdiction over the admission to the practice of law and the discipline of persons admitted."

The Florida Bar has also been charged by the Integration Rule, Article XI, 31 F.S.A. page 706, with the task of disciplining lawyers. The records of the Florida Bar show that since its organization it has recommended the disciplining of a total of 119 lawyers, resulting in 34 disbarments, 40 suspensions, 34 public

reprimands and 11 attorneys placed on probation. These figures do not include 304 complaints processed by grievance committees during the calendar year 1962.

The By Laws of the Integration Rule approved by the Supreme Court also included By Law Article 4, 8 H (31 F.S.A. 720), which established the Committee on Unauthorized Practice of Law, whose duties were stated as follows:

> "h. *Committee on Unauthorized Practice of Law.*
>
> It shall be the duty of this committee to keep under continuing study the subject of unauthorized practice of law, to analyze the measures that exist in Florida, as compared with other states, for preventing such unauthorized practice, and to make investigations of unauthorized practice; and, with the approval of the Board of Governors, this committee may take steps to prevent or to stop the unauthorized practice of law, including the initiation of legal proceedings."

In this way, both The Florida Bar and its Committee on Unauthorized Practice of Law were made official instrumentalities of the system of administration of justice in Florida.

POINT TWO

WHAT ACTS CONSTITUTE THE PRACTICE OF LAW IN FLORIDA HAS BEEN DECIDED BY THE FLORIDA SUPREME COURT AS A MATTER OF STATE LAW, AND SHOULD BE ACCEPTED AS SUCH BY THIS COURT

This Court will recognize the decisions of the highest court of a State on matters of State law. *Greenough v. Tax Assessors* (1947), 331 U.S. 486, 91 L.Ed. 1621, 67 S.Ct. 1400. What acts constitute the practice of law in Florida is a matter of State law which has been decided in the decision below, and should be accepted as such by this Court. In addition, the Brief of the United States points out in a footnote on page 9, and in somewhat different language, that the petition for certiorari does not challenge the decision below as to what acts constitute the practice of law under the law of Florida.

In order, however, that this Court may fully understand the essentially legal character of the acts performed by the Petitioner, they are described in detail in Appendix B to the brief of the American Bar Association as *amicus curiae*, to which we respectfully refer the Court.

POINT THREE

THE STATES, IN THE EXERCISE OF THE POLICE POWER, HAVE THE RIGHT TO CONTROL AND REGULATE THE PRACTICE OF LAW.

A. In General

It appears to be settled doctrine that "the right to control and regulate the granting of license to practice law in the courts of a state is one of those powers that was not transferred to the Federal government". *Bradwell* v. *Illinois* (1873), 16 Wall. 130, 139, 21 L.Ed. 442.

To the same effect:

Theard v. *United States* (1957), 354 U.S. 278, 281, 1 L.Ed. 2d 1342, 77 S.Ct. 1274.

Schware v. *Board of Bar Examiners* (1957), 353 U.S. 232, 1 L.Ed. 2d 796, 77 S.Ct. 752.

Martin v. *Walton* (1961), 368 U.S. 25, 7 L.Ed. 2d 5, 82 S.Ct. 1.

Re Isserman (1953), 345 U.S. 286, 97 L.Ed. 1013, 73 S.Ct. 676.

Re Summers (1945), 325 U.S. 561, 89 L.Ed. 1795, 65 S.Ct. 1307.

Randall v. *Brigham* (1869), 7 Wall. 523, 19 L.Ed. 285.

In re Lockwood (1894), 154 U.S. 116, 38 L.Ed. 929, 14 S.Ct. 1082.

Cummings v. *Missouri* (1867), 4 Wall. 277, 18 L.Ed. 356.

Saier v. *State Bar of Michigan* (CA 6, 1961), 293 F.2d. 756, *cert. denied*, 368 U.S. 947, 7 L.Ed. 2d 343, 82 S.Ct. 388.

Starr v. *State Board of Law Examiners* (CA 7, 1947), 159 F.2d 305.

Mitchell v. *Greenough* (CA 9, 1958) 100 F.2d 184, *cert. denied*, 306 U.S. 659, 83 L.Ed. 1056, 59 S.Ct. 788.

Emmons v. *Smitt* (CA 6, 1945), 149 F.2d 869, *cert. denied*, 326 U.S. 746, 90 L.Ed. 446, 66 S.Ct. 59.

And see Point Four, B, *post* p. 46.

B. The Fact That the Practice of Law Involves Federal Subject Matter Does Not Diminish the Power of the State to Regulate It

The cases appear to universally hold that the power of the State to regulate the practice of law within the State is not diminished by the fact that the subject matter of such practice may be federal in character.

Here perhaps the leading case is *Ginsburg* v. *Kovrak* (1958), 392 Pa. 143, 139 A.2d 889. Kovrak was admitted to practice before the United States Supreme Court, the Court of Appeals of the District of Columbia, and the Eastern District of Pennsylvania. He was not a member of the Pennsylvania Bar, but he set up an office in Philadelphia and advertised himself as "Attorney at Law. Practice in Federal Taxation." The Committee on the Unauthorized Practice of Law of the Philadelphia Bar Association then sued to enjoin Kovrak from unlawfully practicing law in the State. The Defendant's position was that "he has a legal right to practice law anywhere in the Eastern District of Pennsylvania with regard to any legal matter in which a Federal question was involved, no matter how remote." 139 A. 2d 890. In enjoining the Defendant from practicing law in Pennsylvania, the Court among other things, said:

> "When a stranger comes to our community he must meet the standards set out by our people, just

as our citizens must expect to meet the local standards if they go elsewhere to live and work. *No case has been suggested to us which holds that membership in the Bar of the United States Supreme Court entitles an attorney to practice anywhere in the United States without reference to local State requirements.* If we are not obliged to accept the man from Oregon merely because he may practice before the Supreme Court, neither should we have to accept the stranger from Pike County as a practicing lawyer merely because it is also within the Eastern District of Pennsylvania.

"We do not presume to tell the Federal Courts whom they should or should not appoint as referees, special masters, amici curiae, and the like, for the prosecution of their work as they see it. That is a different matter from deciding what qualifications are needed by Pennsylvania citizens facing and affecting each other before the Bar in any court of law, State or Federal. In such matters we are State citizens before we are federal citizens, which is another way of saying that the States have not ceded to the Federal Government the right to qualify their lawyers." (Emphasis added.) Page 892.

* * * * * * * * * *

"Merely because the Federal courtrooms are open does not mean that the Federal Courts have approved anyone as a qualified lawyer. The *most it means is that a man may practice there if he is qualified by local law.*" (Emphasis added.) Page 893.

* * * * * * * * * *

"It is readily apparent that *the injunction is intended to, and does, prohibit only the maintenance of an office and the practice of law* in Philadelphia County (and, of course, anywhere else in

the Commonwealth of Pennsylvania). *It in no way affects the appellant's right to engage in the practice of law in Washington, D. C.*, or to try cases in the United States District Court for the Eastern District of Pennsylvania or in any other federal court or jurisdiction where he may be entitled to practice." (Emphasis added.) Page 893.

C. Admission to Practice Before a Federal Tribunal Does Not Entitle One to Practice Law in a Particular State

1. Admission to practice before a Federal Court does not entitle one to practice in a particular state

Here again perhaps the leading case is *Ginsburg* v. *Kovrak* (1958), 392 Pa. 143, 139 A. 2d 889, *supra*. Kovrak was a member of the Bar of this Court and of Courts in the District of Columbia, and of the United States District Court for the Eastern District of Pennsylvania. The Supreme Court of Pennsylvania held that he could not practice law in the State of Pennsylvania inasmuch as he was not a member of the Pennsylvania Bar. The quotations given above, are also specially pertinent on this point.

And in *Petition of Kearney*, 63 S. 2d 630 (Florida 1953), extensively relied upon by the Court below, Kearney was duly admitted to practice before this Court, the Tax Court of the United States, and the Treasury Department. He was not a member of The Florida Bar, but he sought permission to practice in Florida as "Federal Tax Counsel," with Court appearances to be limited to the Federal Courts and departments described. The Florida Supreme Court held that such practice would constitute the practice of law in Florida and that in order to engage in such practice Kearney would have to become a member of The Flor-

ida Bar "subject to the jurisdiction of this Court" (R. 56). In its opinion the Florida Supreme Court stressed Section 2, Integration Rule, which provides that no person shall engage in any way in the practice of law in the State unless he is an active member of The Florida Bar.

Similarly, lay agencies have been enjoined from practicing law where the acts included bankruptcy legal work. *Richmond Association of Credit Men* v. *Bar Association* (1937), 167 Va. 327, 189 S.E. 153; *Depew* v. *Wichita Ass'n of Credit Men* (1935), 142 Kan. 403, 49 P.2d 1041 *cert. denied*, 297 U.S. 710, 80 L.Ed. 997, 56 S.Ct. 574. A lay agency has also been enjoined from practicing law where the acts include collection of the purchase price of interstate sales which, it was claimed, would interfere with interstate commerce. *State Ex. Inf. McKittrick* v. *C. S. Dudley & Co.* (1937), 340 Mo. 852, 102 S.W. 2d 895.

The cases above set forth are discussed and quoted from at great length in the Brief of the American Bar Association as *amicus curiae*, pages 38, 39.

2. Admission to practice bfeore a Federal Administrative Agency does not entitle one to practice law in a particular state

There are cases, *De Pass* v. *B. Harris Wool Co.*, (1940), 346 Mo. 1038, 144 S.W. 2d 146, *Auerbacker* v. *Wood* (1947), 139 N.J.E. 599, 53 A. 2d 800; *In re Lyon* (1938), 301 Mass. 30, 16 N.E. 2d 74; and *Noble* v. *Hunt* (1957), 95 Ga. 804, 99 S.E. 2d 345, which indicate that a state will not interfere with the *appearance* of a layman before a Federal administrative agency, where such appearance has been authorized by the agency.

Other state cases, however, hold that admission to practice before a federal administrative agency does not authorize a person to practice law in a state, as distinguished from making appearances before the agency.

There are two landmark cases so holding. In *Chicago Bar Association* v. *Kellogg*, 338 Ill. App. 618, 88 N.E. 2d 519 (1949), the Appellate Court of Illinois held that admission to practice before the Patent Office in 1918 did not authorize the practice of law relating to patents in Illinois by a "patent attorney" not a member of the Illinois bar. We quote from the opinion at length (88 N.E. 2d 519, 521-528) because it is so directly pertinent to our case:

> "The complaint charges substantially that the defendant maintains an office in the City of Chicago; that he is not licensed to practice law in the State of Illinois, but notwithstanding has for a long time engaged in, and continues to engage in, the practice of law and *holds himself out as an attorney* and induces, or attempts to induce, the public to believe that he is an attorney at law. The complaint itemizes a number of specific acts which it charges constitutes the practice of law, and prays that the defendant be restrained from a continuation of these specified practices.
>
> "The answer admits that defendant is a resident of Cook County and states that on December 16, 1918, while defendant resided in the City of Washington, the Commissioner of Patents of the Patent Office of the United States caused the name of the defendant to be duly registered on the Roster of Attorneys entitled to practice before it, and by virtue of such license he became entitled to perform certain services before the Patent Office and elsewhere.

"Defendant's contention is based on his interpretation of the rules of the United States Patent Office in force in the year 1918 at the time of his registration in the United States Patent Office, the pertinent rule 17 then being as follows:

"'*A register of attorneys will be kept in this office, on which will be entered the names of all persons entitled to represent applicants before the Patent Office in the presentation and prosecution of applications for patent.* * * *

"'(b) Any person not an attorney at law who is a citizen or resident of the United States who has had three years' experience in patent work under the personal direction and supervision of a duly registered patent attorney * * * and who shall file proof to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the necessary legal and technical qualifications to enable him to render applicants for patents valuable service and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.'

* * * * * * * * * *

"The decree found substantially as follows: that the defendant is not licensed to practice law in the State of Illinois or elsewhere, but on December 16, 1918 was registered to practice before the United States Patent Office; that about January, 1930, defendant moved to Chicago and opened offices at 35 East Wacker Drive, has maintained offices there continuously, and has practiced during all of such time as a patent attorney upon a paid basis; that from 1931 to 1941 he had as office associates men who had been admitted to the bar of the State of Illinois; that the stationery used in the early part of his practice described himself as an attorney without qualifications as to his limitations, and had associated with him as 'of counsel' men who were admitted to the bar of the State of

Illinois; that his stationery was changed in 1941 to read, 'Patent Attorney' and 'Patent and Trade Mark Attorney'; that in several instances the defendant employed attorneys whom he paid for legal services from fees which he collected from his clients and that he employed attorneys for work to be done for clients whom such attorneys had never met and without the relationship of attorney and client ever having been established; that defendant in his correspondence had repeatedly held himself out as 'attorney at law' and that he has also participated as an attorney at law in legal proceedings; that the defendant repeatedly construed patent licenses and gave opinions with respect to the infringement of patents and on at least one occasion wrote a letter charging a company with violation of, and infringement upon, certain patents of a client of defendant, threatening it with litigation; that defendant has been paid for legal services involved in the preparation of infringement opinions and has made a charge in relation to an infringement suit, including the study of patent claim, extension of time in which to file defendant's answer, study of license agreement and preparation of an answer in the infringement suit.

* * * * * * * * * *

"The decree enjoins the defendant, his agents and employees from:

"'(1) Rendering legal opinions relating to infringement and enforcement of patents and trade marks;

"'(2) Preparing, drafting and filing pleadings and other legal documents and papers in suits at law and in equity in courts of record and before administrative tribunals, *other than the United States Patent Office;*

"'(3) Participating as an attorney in legal proceedings *other than United States Patent Office;*

"'(4) In behalf of persons represented by him, threatening to bring suit against other parties;

"'(5) Preparing and serving notice of and asserting attorney's lien under Section 14 of Chapter 13, Illinois Revised Statutes; and

"'(6) Charging and collecting fees for legal services rendered by him or rendered by him and by others in legal proceedings, *other than wherein the United States Patent Office has jurisdiction.*'

* * * * * * * * *

"We have come to the conclusion that the evidence before us clearly indicates that for a long period of time defendant was engaged in the unauthorized practice of law within the meaning of the Illinois authorities; and we are of the opinion that the courts of the State of Illinois have the power to determine what contravenes its policy in this respect independent of any other authority. Article I, Section 8, of the constitution of the United States, under which provision defendant claims his rights were violated, provides, 'The Congress shall have Power * * * To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries * * *.' *Defendant further maintains that the power to regulate patents was by an Act of Congress conferred upon the Department of the Interior at the time the license was issued to him, and that under its authorization the Patent Office was empowered to permit certain practitioners, including the defendant, to practice before it.*

"The fallacy of defendant's argument lies in the implication that the Patent Office had the right to permit the exercise of prerogatives which are forbidden under the laws of the State of Illinois as constituting unauthorized practice. No such authorization was issued by the United States Patent Office to defendant, nor was any power inherent

in the Patent Office to permit defendant to practice law.

"*Defendant argues that* the United States Patent Office makes no distinction as to the rights or duties of attorneys at law and patent attorneys who were not attorneys at law, but who were admitted prior to the change in the rules; and that *patent attorneys who were not attorneys at law* and were admitted prior to the change *have the same rights, privileges, and duties as the patent attorneys at law* who solely are admitted under the new rule. *With this proposition we thoroughly disagree. The Patent Office did not undertake to invest non-attorneys with the same rights, privileges, and duties as those had by attorneys at law incontravention of the well defined rulings of the courts of Illinois.* The police power and the procedure thereunder covering the enrollment and disbarment of lawyers and the punishment of unauthorized practitioners subject to its jurisdiction is a matter reserved for determination by the Judicial Department of the State of Illinois. As was said in Pennoyer v. Neff, 95 U.S. 714, at page 722, 24 L. Ed. 565:

"'* * * every State has the power to determine for itself the civil status and capacities of its inhabitants; to prescribe the subjects upon which they may contract, the forms and solemnities with which their contracts shall be executed, the rights and obligations arising from them, and the mode in which their validity shall be determined and their obligations enforced; and also to regulate the manner and conditions upon which property situated within such territory, both personal and real, may be acquired, enjoyed, and transferred. * * *'

* * * * * * * * *

"The Patent Office, however, did not attempt to enlarge upon its authority as it never attempted to authorize defendant to practice law. *Rule 17 in*

effect prior to 1938 merely provided that, in the very limited field defined, qualified non-attorneys might represent applicants 'in the presentation and prosecution of applications for patents.' This is a far different proposition from the one for which counsel contends, namely, that non-attorneys at law have the same rights, privileges, and duties as patent attorneys at law. The injunctional order does not take away any constitutional rights of defendant because the defendant never had any right, either directly or indirectly, to practice law.

• • • • • • • • • •

"Another consideration which weighs heavily with this court is the fact that up until the date of the filing of the bill in this case defendant used letterheads which would lead any layman who viewed them to conclude that defendant was a patent attorney vested with all the capabilities and privileges of an attorney at law. In a case of this kind, the general welfare of the public is of primary concern. The public are entitled to protection against unauthorized practitioners of the law, and the courts should lend a ready hand to suppress the evil by way of injunctional relief wherever it appears. The fact that the unauthorized practice may have been without malevolence, under a misapprehension as to rights, renders the menace none the less formidable nor the remedy by injunction none the less appropriate."

• • • • • • • • • •

"From what we have heretofore said, it is obvious defendant has no right to charge or collect fees for legal services. *In restricting defendant's disability to charge and collect fees for legal services rendered in proceedings other than where the Patent Office has jurisdiction, the chancellor was in error,* and the cross-error of plaintiffs on this score is well assigned. *Defendant has no right to collect fees for legal services wherever rendered.*

"Plaintiff assigns cross-error on finding 18 of the chancellor, which finding is as follows:

"'18. The Court further finds that the defendant has been preparing, drafting and construing assignments, leases and other documents relating to letters patent. The rules of the United States Patent Office provide forms for the preparing of certain papers, including the assignment of patents, licenses for royalty and many other forms. Whether such forms may be used and are intended for use of Patent Attorneys, whether they are licensed to practice in a state or have a license similar to the license issued to the defendant, should properly be determined by the United States Patent Office. *In the preparation, drafting and construing of assignments, leases and licenses, the defendant has not been practicing law in violation of the law of the State of Illinois.*'

"*This finding of the decree, to which cross-error is assigned, is erroneous. The courts of the State of Illinois, and not the United States Patent Office, may determine what constitutes the illegal practice of law in this State.* The fact that the defendant used forms instead of original documents is not controlling upon the question of whether or not he was engaged in the practice of law. We have heretofore said that the preparing, drafting, and construing of assignments, leases, and other such documents relating to letters patent, constitute the practice of law; and insofar as the decree authorizes the preparation, drafting, and filing of pleadings anywhere, it is erroneous.

"Defendant in his answer has asserted that he has the right to perform certain specified services. In his reply brief he asserts that the only issue before this court is to determine whether or not he has the legal right to perform these acts. *The issue before us is not what things defendant may do under the authority he claims from his license to appear before the United States Patent Office,*

but what things, if any, he has done in violation of the laws of the State of Illinois and what, from his past conduct, he may reasonably be expected to do in the future. . . .

* * * * * * * * *

"Accordingly, the decree of the Superior Court is reversed and the cause is remanded with directions *to enter a decree which shall be without prejudice to defendant's rights to advise and assist applicants for patents in the presentation and prosecution of their applications for patents before the United States Patent Office, but which shall enjoin the defendant from the following activities:*

"1. *Giving legal advice;*

"2. *Preparing, drafting and construing legal documents,* contracts, including patent licenses and deeds, assignments and other evidences of transfer of title to or interests in patent and other property;

"3. *Rendering legal opinions,* including legal opinions relating to title to, and validity, infringement and enforcement of, patents and trade marks and rights therein and thereto;

"4. *Preparing, drafting and filing pleadings and other legal documents* and papers *in suits at law and in equity,* in courts of record and before administrative tribunals, *other than the Patent Office;*

"5. *Participating, as an attorney, in legal proceedings;*

"6. In behalf of persons represented by him, threatening to bring suit against other parties;

"7. Preparing and serving notice of and asserting attorney's lien under Section 14 of Chapter 13, Illinois Revised Statutes;

"8. Charging and collecting fees for legal services rendered by him and rendered by him and others." (Emphasis added.)

Tax Law: Agran v. Shapiro. The argument that practice before the Treasury Department pursuant to the Act of July 7, 1884, 23 Stat. 258, 5 U.S.C. § 261 (which is virtually identical to Rev. Stat. § 487), included an authorization to practice law relating to federal taxation in California was decisively rejected in *Agran* v. *Shapiro* (1954), 127 Cal. App. 2d 807, 273 P. 2d 619. In that case, the Court denied recovery of a fee for legal services incident to federal taxation rendered in California by an accountant admitted to practice before the Treasury Department, but not admitted to practice law in California, on the ground that the accountant was engaged in the unauthorized practice of law. Again, we quote from the opinion at length (273 P. 2d 619, 627-630) because of its special pertinence to our case.

> "From what has been said, we would have but little hesitancy in concluding that the services rendered by plaintiff other than those involved in the preparation of the income tax returns and possibly others of an accounting character constitute the practice of law as that term has been judicially defined in this State. Kountz v. Rowlands, 1943, 46 Pa. Dist. & Co. 461, 463. The more serious questions which present themselves, however, are (1) whether the controlling test of what constitutes the practice of law in the field of federal income taxation is dictated by federal legislation, congressional or administrative, and (2) the effect of the federal regulations which have been adopted in this field. Upon behalf of the plaintiff, it is urged by *amicus curiae* that an affirmative answer is required to the first inquiry and that, inasmuch as plaintiff was enrolled as an agent in the Treasury Department, and by virtue thereof licensed to practice before that Department, all of his activities in the instant case were within the scope of such license, and any action by a state court which would interfere with or curtail the right so granted is not only unwarranted but unconstitutional.

"By the Act of July 7, 1884, sec. 3, 23 Stat. 258, 5 U.S.C.A. § 261, the Secretary of the Treasury is authorized to prescribe 'regulations governing the recognition of agents * * * representing claimants before his departments * * *.' Pursuant to this statutory authority, the Secretary issued Circular 230 (now parts 10 and 13, Subtitle A, Tit. 31, Code Fed. Reg.), which insofar as material here reads as follows: 'An agent enrolled before the Treasury Department shall have the same rights, powers and privileges and be subject to the same duties as an enrolled attorney: *Provided*, that an enrolled agent shall not have the privilege of drafting or preparing any written instrument by which title to real or personal property may be conveyed or transferred for the purpose of affecting Federal taxes, nor shall such enrolled agent advise a client as to the legal sufficiency of such an instrument or its legal effect upon the Federal taxes of such client: *And provided further, That nothing in the regulations in this part shall be construed as authorizing persons not members of the bar to practice law.*' Code Fed. Reg., sec. 10.2(f), Tit. 31, Subtit. A, Part 10.

"'Practice before the Treasury Department shall be deemend to comprehend all matters connected with the presentation of a client's interests to the Treasury Department, including the preparation and filing of necessary written documents, and correspondence with the Treasury Department relative to such interests. Unless otherwise stated, the term "Treasury Department," as used in this paragraph and elsewhere in this part, includes any division, branch, bureau, office, or unit of the Treasury Department, whether in Washington or in the field, and any officer or employee of such division, branch, bureau, office or unit.' Id., sec. 10.2(b).

"In this connection also, reference should be made to Rule 2 of the former United States Board of Tax Appeals, 26 U.S.C.A. Int. Rev. Code, fol-

lowing sec. 5011, now Tax Court of the United States,[5] for the admission to practice, after examination, of citizens without restriction to members of the bar or certified public accountants, and the validity of such rule has been recognized. Goldsmith v. U. S. Board of Tax Appeals, 1926, 270 U. S. 117, 46 S. Ct. 215, 70 L. Ed. 494, 496; Crane-Johnson Co. v. Commissioner of Internal Revenue, 8 Cir., 1939, 105 F. 2d 740, 744. . . .

* * * * * * * * *

"No case which we have been able to discover has undertaken to directly decide the precise question with which we are confronted, namely, whether the Treasury Regulations referred to have the effect of declaring that service performed by an enrolled agent in connection with federal income tax matters do not constitute the practice of law in the sense that such practice is prohibited, by state law, when engaged in by other than members of the bar. . . .

* * * * * * * * *

"More closely in point and supporting plaintiff's position is De Pass v. B. Harris Wool Co., 1940, 346 Mo. 1038, 144 S.W. 2d 146, wherein plaintiff, a non-lawyer licensed to practice before the Interstate Commerce Commission, sought to recover for services rendered *before that body in certain rate reduction cases* on behalf of the defendant. Defendant demurred upon the ground that the alleged contract called for services which, under the law of Missouri, constituted the practice of law, and hence plaintiff was barred from recovery. The Supreme Court of Missouri, though apparently of the view that, judged by Missouri law, the services in question constituted the practice of law, held that the question was foreclosed by the Rules of Practice of the Interstate Commerce Commission, 49 U.S.C.A. Appendix following sec. 1185, which permitted laymen licensed by it to practice

[5] 26 U.S.C.A. § 1111.

before it. Says the court, 144 S.W. 2d at page 148: 'Defendant seems to argue that the right to define the practice of law and to regulate persons engaging in such practice falls within the police power of the state. So it does, except in so far as that right does not run contra to an Act "made in pursuance" to the Federal constitution.'

"It does not appear, however, that the rule of the Interstate Commission there involved contained any limitation with respect to the practice of law as does the Treasury Regulation under consideration.

"In re Lyon, 1938, 301 Mass. 30, 16 N. E. 2d 74, cited on behalf of plaintiff, and relied upon in De Pass v. B. Harris Wool Co., just considered by us, is, we believe, factually distinguishable. Moreover, it must be viewed in the light of the discussion in the more recent decision of the same court —Lowell Bar Ass'n v. Loeb, 1943, 315 Mass. 176, 52 N.E. 2d 27, wherein the court adverted to but did not undertake to determine the effect of the Treasury Regulations previously referred to. The court there said, 52 N.E. 2d at page 33: '*Neither do we consider at this time whether the permission granted to certified public accountants and other persons not members of the bar to practise in tax matters by the rules of the United States Treasury Department and of* the administrative tribunal (Helvering v. Rankin, 295 U. S. 123, 131, 55 S. Ct. 732, 79 L. Ed 1343; Higgins v. Commissioner of Internal Revenue, 312 U.S. 212, 61 S. Ct. 475, 85 L. Ed. 783) now called *the Tax Court* of the United States, *can have the effect of granting by implication to holders of "Treasury enrollment cards" a right to perform in this Commonwealth services in connection with Federal taxes which in their nature are comprised in the practice of law.* It may deserve consideration whether the rules of a Federal administrative tribunal can legalize acts done in the States in matters not actually before the tribunal, though of a class that might eventually

come before it. Matter of Lyon, 301 Mass. 30, 34-36, 16 N.E. 2d 74; De Pass v. B. Harris Wool Co., 346 Mo. 1038, 144 S.W. 2d 146."

"Were we convinced that the effect of the Treasury Regulations is to declare that acts constituting the practice of law in the accepted sense could lawfully be performed by non-members of the bar, we would entertain the same doubts as those suggested by the Supreme Judicial Court of Massachusetts in the portion of the opinion quoted above. Cf. Chicago Bar Ass'n v. United Taxpayers of America, 1941, 312 Ill. App. 243, 38 N.E. 2d 349, holding the rule of Department of Finance permitting non-lawyers to appear before it in behalf of taxpayers void insofar as it purported to authorize such to perform acts constituting practice of law. *We do not, however, believe that the regulations in question were intended to or have the effect contended for on behalf of plaintiff. We regard as highly significant the concluding clause in section 10.2(f) 'that nothing in the regulations in this part shall be construed as authorizing persons not members of the Bar to practice law.'* This statement must be read in context with the opening sentence of the section providing that 'An agent enrolled before the Treasury Department shall have the same rights, powers and privileges * * * as an enrolled attorney' and as qualifying the same. As admittedly the Treasury Department is without authority to prescribe the rights and privileges to be exercised by persons except those appearing before it upon behalf of others, this provision could only have been intended as a disavowal of any intent upon the part of the Secretary of the Treasury to confer authority upon enrolled agents, not members of the bar, to perform acts upon behalf of others in connection with matters before the department which would otherwise constitute the practice of law. We cannot subscribe to the argument advanced upon behalf of the plaintiff that this provision was

merely 'a catch-all clause designed to prevent enrolled agents from holding themselves out as general attorneys' and 'to limit the authority granted an enrolled agent to the precise field of Federal income taxation.' Rather it suggests a recognition that 'practice before the Treasury Department,' while it may include acts which do not constitute the practice of law, and hence within the authority of enrolled agents, though not lawyers, to perform, also comprehends others of such character as to bring them within this classification. See Petition of Kearney, Fla. 1953, 63 So. 2d 630.

"In essence plaintiff's contention is that the effect of the Treasury Regulations is to declare that an enrolled agent, though not a lawyer, may, in the representation of others in tax matters before the Treasury Department, lawfully perform all of the services which a member of the bar is authorized to perform except 'the privilege of drafting or preparing any written instrument by which title to real or personal property may be conveyed or transferred for the purpose of affecting Federal taxes' or advising 'a client as to the legal sufficiency of such an instrument or its legal effect upon the Federal taxes of such client.' If this be true, we see no reason for the concluding proviso in 10.2(f), disavowing any intent to thereby authorize non-lawyers to perform acts in connection with tax matters before the Department which would constitute the practice of law." (Emphasis added.)

In the second *Agran* case, dated September 20, 1956 (Unauthorized Practice News Volume XXII, December, 1956, No. 4, page 34) the California Court, among other things, made the following significant statement:

"Reduced to its simplest form, plaintiff's argument in effect is this: by virtue of the Treasury Regulation (31 C. F. R. § 10.2) an enrolled agent

(though) through a non-lawyer is at liberty to perform any and all services and give advice upon legal questions which constitute the practice of law within the meaning of that term as generally understood so long as the work is performed or the advice is given in connection with a matter involving or arising under the federal Internal Revenue Code and pending before the Treasury Department. This is pointed up by plaintiff's suggestion that the decision in the *Bereu* case (78 N.Y.S. 2d 209) would have been different if the respondent there had been enrolled (which he was not) as an agent by the Treasury Department, but if that court was correct, as we believe it was, in concluding that the services rendered by Mr. Bereu constituted the practice of law, the necessary effect of plaintiff's argument is that a state may not regulate the practice of law within its borders by prohibiting laymen from practicing law at least insofar as relates to matters and questions arising under Internal Revenue Code so that what constitutes the practice of law no longer depends upon what is done but by whom. If this be true, the same act which would constitute the practice of law under the law of this State if performed here and which if performed by a non-lawyer not enrolled as an agent by the Treasury Department would subject him to criminal prosecution, would not constitute the practice of law if performed by a non-lawyer so enrolled. *To accept the plaintiff's argument would simply mean that the individual States are in effect deprived of their traditional and long recognized right to regulate the practice of law within their borders at least insofar as such practice involves matters of so-called 'tax-law.'* If this is to be the rule we feel it should be announced by some higher authority.

"Nothing said herein or in our previous opinion implies a holding, as plaintiff seems to think, that the Treasury Department may not prescribe the qualifications of those whom it will recognize as

> agents or attorneys of others having business with the Department but rather that by such recognition it may not confer upon persons who are not members of the bar authority to perform services within a State which, under its laws, constitute the practice of law in violation of that State's laws." (Emphasis added.)

Despite the invitation in the penultimate paragraph of the Court's opinion above, to petition this Court for certiorari, no such petition was ever filed.

In *In Re Bercu* (1948), 273 App.Div. 524, 78 N.Y.S. 2d 209, 9 A.L.R. 2d 787, affirmed 299 N.Y. 728, 87 N.E. 2d 451, the New York Court recognized that admission by an accountant to the Treasury Department did not give him a right "to practice tax law at large," saying:

> "We are unable, therefore, to regard the admission of accountants, subject to certain qualifications and regulations of the Treasury Department and the Tax Court, to practice before those agencies, as an authorization to accountants to practice tax law at large or as an eradication of the distinction between the lawyer's and the accountant's function in the tax field."

Other cases in which the courts have recognized that admission to practice before Federal agencies does not constitute a license to practice law without compliance with State regulation of the practice of law include the following:

> *Petition of Kearney* (Fla. 1953), 63 So. 2d 630 (practice before the Treasury Department pursuant to 5 U.S.C. § 261, does not authorize practice of federal tax law in Florida).
>
> *In re Gibbs* (Arizona 1929), 278 P. 371 (practice before the Interior Department pursuant to 5 U.S.C. § 493 does not authorize Arizona member of the bar to solicit such practice).

POINT FOUR

THE COURTS VESTED WITH JUDICIAL POWER HAVE THE EXCLUSIVE RIGHT TO ADMIT PERSONS TO THE BAR AND TO DISBAR, AND TO DEFINE WHAT CONSTITUTES THE PRACTICE OF LAW AND TO EXCLUDE UNAUTHORIZED PERSONS THEREFROM. THE LEGISLATURE HAS NO POWER TO AUTHORIZE PEOPLE TO PRACTICE LAW

A. The Courts Vested With Judicial Power Have the Right To Admit To the Bar and To Disbar

The Constitution of the United States vests the judicial power in the Courts. It has accordingly been held by this Court that "admission" to the Bar is "the exercise of judicial power and has been so held in numerous cases." *Ex Parte Garland*, 4 Wall. (1867), 333, 378, 18 L.Ed. 370; *Theard* v. *United States* (1957), 354 U.S. 278, 1 L.Ed. 2d 1342, 77 S.Ct. 1274, *supra*, p. 19.

The State cases universally hold to the same effect, as will be pointed out in the next section, B.

B. "Authority to Admit to the Bar and to Disbar Necessarily Carries With It Power to Define What Constitutes the Practice of Law and to Exclude Unauthorized Persons Therefrom."

It appears to be universally the law, as was said in *Rhode Island Bar Association* v. *Automobile Service Association* (1935), 55 R.I. 122, 179 A. 139, 142, that "authority to admit to the bar and to disbar necessarily carries with it the power to define what constitutes the practice of law and to exclude unauthorized persons therefrom."

To the same effect, *In Re Opinion of the Justices* (1935), 289 Mass. 607, 194 N.E. 313; *People* v. *People's Stock Yards State Bank* (1931), 344 Ill. 462, 176 N.E. 901, *supra*, and *Bump* v. *District Court of Polk County* (1942), 232 Iowa 623, 5 N.W. 2d 914.

The foregoing cases are set forth and discussed at length in the brief of the American Bar Association as *amicus curiae* filed contemporaneously herewith, p. 60-65, to which we respectfully refer the Court. In addition, the American Bar brief sets forth a considerable number of additional cases so holding.

Accordingly, it is the universal weight of authority that, where the judicial power of government is vested in the Courts, the Congress or a State legislature may not authorize a person to practice law.

C. Neither the Legislature Nor an Administrative Agency May Authorize a Person to Practice Law Before the Agency

It appears to be the universal weight of authority that, where the judicial power is vested in the Courts, neither the State legislature nor a State administrative agency may authorize a person to practice law.

Thus, in *State ex rel. Johnson* v. *Childe* (1941), 139 Neb. 91, 295 N.W. 381, the Court held that neither the state statutes nor the rules of the Railway Commission of Nebraska could authorize the practice of law by a layman before an administrative agency. The court, among other things, said:

> "These sections of the statute convey broad powers upon the railway commission with reference to its procedure, but *they do not authorize one not admitted to the bar to engage in the practice of law.* The determination of the persons to be licensed to practice law is a judicial function over which the courts have exclusive control. The issue therefore resolves itself into the question whether the acts performed by respondent amounted to the practice of law." (Emphasis added.)

To the same effect:

State of Wisconsin v. *Keller* (1962), 16 Wis. 2d 377, 114 N.W. 2d 796, petition for certiorari filed Oct. 12, 1962, 31 U.S. Law Week 3104 (No. 429 Oct. Term, 1962).

Hoffmeister v. *Todd* (Mo. 1961), 349 S.W. 2d 5.

People v. *Goodman* (1937), 366 Ill. 346, 8 N.E. 2d 941.

Clark v. *Austin* (1937), 340 Mo. 467, 101 S.W. 2d 977.

Chicago Bar Association v. *United Taxpayers of America* (1941), 312 Ill. App. 243, 38 N.E. 2d 349.

Appeal of Bailey (Ohio App. 1956), 137 N.E. 2d 528.

State ex rel Daniel v. *Wells* (1939), 191 So. Car. 468, 5 S.E. 2d 181.

The cases above set forth are discussed at greater length in the brief of the American Bar Association as *amicus curiae*, pp. 64-72.

POINT FIVE

CONGRESS HAS NOT ATTEMPTED TO AUTHORIZE THE COMMISSIONER TO AUTHORIZE THE PETITIONER TO PRACTICE LAW RELATING TO PATENTS, BUT ONLY TO PREVENT INCOMPETENT AND DISREPUTABLE PERSONS FROM REPRESENTING INVENTORS BEFORE THE PATENT OFFICE.

A. The Statute On Its Face Is Essentially of a Housekeeping Character and Does Not Purport to Authorize Anyone to Practice Patent Law

In 1928, when Petitioner was registered by the Patent Office as a "patent attorney," practice before the Patent Office was governed by section 487 of the Revised Statutes as amended by section 3 of the Act of February 18, 1922, 42 Stat. 390, 35 U.S.C. § 11 (1946). Section 487, and its current codification as 35 U.S.C. §§ 31 and 32, provides authority for the Commissioner of Patents only to prescribe rules (subject to approval by the agency head) appropriate to "the recognition of agents, attorneys, or other persons" to represent inventors and others "in the presentation or prosecution of their applications or other business before the office," and to "suspend or exclude" "incompetent or disreputable" persons from further practice before his office. This language does not attempt to authorize anyone to practice law relating to patents in Florida or anywhere else, nor does it disclose any such Congressional purpose. On the contrary, the language of section 487 is essentially of a housekeeping character. See *Goldsmith* v. *United States Board of Tax Appeals* (1926), 270 U.S. 117, 70 L.Ed. 494, 46 S.Ct. 215; *Phillips* v. *Billinger* (1916), 37 App. D.C. 46, 49, *appeal dismissed sub. nom. Phillips* v. *Fisher* (1913), 229 U.S. 630, 57 L.Ed. 1358; 16 *Ops. Att'y Gen.* 488 (1880).

In *Goldsmith* v. *United States Board of Tax Appeals* (1926), 270 U.S. 117, 70 L.Ed. 494, 46 S.Ct. 215, this

Court held that the statutory authority of the Board of Tax Appeals to conduct its proceedings "in accordance with such rules of evidence and procedure as the Board may prescribe" included the power to adopt rules for the admission of attorneys and accountants to practice before the Board. In that case, the Board had excluded the petitioner, an accountant, from admission to practice on *ex parte* considerations. In a mandamus proceeding to compel his admission the petitioner argued that the Board had no power to limit the taxpayer's choice of representative. In rejecting this argument, this Court likened the Board's statutory power to prescribe rules of procedure to express statutory provisions authorizing the Secretary of the Treasury and the Secretary of the Interior to prescribe rules "governing the recognition of agents, attorneys, or other persons representing claimants before his department" under the Acts of July 7, 1884, 23 Stat. 258, 5 U.S.C. § 261, and July 4, 1884, 23 Stat. 101, 5 U.S.C. § 493 (270 U.S. 117, 121, 122):

> "We think that the character of the work to be done by the board, the quasi judicial nature of its duties, the magnitude of the interests to be affected by its decisions, all require that *those who represent the taxpayers in the hearings* should be persons whose qualities as lawyers or accountants will secure proper service to their clients and to help the board in the discharge of its important duties. *In most of the executive departments in which interest of individuals as claimants or taxpayers are to be passed on by executive officers or boards, authority is exercised to limit those who act for them as attorneys to persons of proper character and qualification to do so. Not infrequently, statutory provision is made for requiring a list of enrolled attorneys to which a practitioner must be admitted by the executive officer or tribunal.* Act

> of July 7, 1884, 23 Stat. at L. 236, 258 . . . [5 U.S.C. § 261]; Act of July 4, 1884, 23 Stat. at L. 98, 101 . . . [5 U.S.C. § 493]; Act of June 10, 1921, 42 Stat. at L. 25 . . . [31 U.S.C. § 52 (f)]. In view of these express provisions, it is urged that the absence of such authority in case of the board of tax appeals should indicate that it was not intended by Congress to give it the power. *Our view, on the contrary, is that so necessary is the power and so usual is it that the general words by which the board is vested with the authority to prescribe the procedure* in accordance with which its business shall be conducted *include* as part of the procedure *rules of practice for the admission of attorneys. It would be a very curious situation if such power did not exist in the board of tax appeals when in the Treasury Department and the office of the Commissioner of Internal Revenue there is a list of attorneys enrolled for practice in the very cases which are to be appealed to the board.*" (Emphasis added.)

In no way did this Court intimate that the statutory authority of the Board or of the Secretaries of the Treasury and Interior Departments under the 1884 Acts—the language of which is substantially identical to the statutory authority of the Patent Office under § 487 of the Revised Statutes—extended beyond the housekeeping power to exclude, by fair procedures, unsuitable persons from "representing" persons "in the hearings" before the board. For it is inconceivable that the admission of accountants to practice before the Board of Tax Appeals constitutes an authorization to practice law relating to federal taxation throughout the several States without regard to State regulation of the practice of law.

In *Phillips* v. *Ballinger*, *supra*, an attorney at law sought to enjoin the Secretary of the Interior from

disbarring him from practice before the Interior Department on the ground that the statute authorizing the disbarment (section 5 of the Act of July 4, 1884, 23 Stat. 101, 5 U.S.C. § 493) was void on due process grounds due to the vagueness of the term "disreputable" and due to the failure of the statute to provide for the swearing of witnesses in disbarment proceedings thereunder. This section of the 1884 Act contained essentially the same language as was added to section 487 of the Revised Statutes by the Act of February 18, 1922, *supra*. In affirming dismissal of the bill and upholding the statute, the Court of Appeals stated that "it is unnecessary to consider whether [the 1884 Act] constitutes anything more than a legislative sanction of the practice heretofore existing" since "prior to the passage of the Act," by virtue of section 161 of the Revised Statutes, 5 U.S.C. section 22, "*the Secretary certainly had the power to prescribe rules governing the conduct of agents and attorneys in his department*," and *this "would seem to include the power to exclude such agents* and attorneys as the Secretary, after notice and hearing, should find no longer entitled to enjoy the privileges theretofore granted." *Id.* at 49. (Emphasis added.)

Moreover, in 16 *Ops. Att'y Gen.* 148 (1880), the Attorney General pointed out that agency heads had authority to regulate practice before their departments in the absence of express statutory provisions:

> "Referring to your informal note of the 21st of April, I would answer that the Secretary of the Interior has authority to disbar for misconduct attorneys practicing before his Department. This authority is not given by statute, but seems to have been one exercised heretofore by heads of Depart-

ments in the protection of the Government. Its limits were defined by Attorney-General Hoar [in 13 Ops. Att'y Gen. 150] as follows:

> 'It is competent to the head of a Department as a measure for the protection of the public interests committed to his charge, *to decline to recognize or to suspend the transaction of business with an agent or attorney for frauds and fraudulent practices* attempted or committed by him in the prosecution of claims before the Department, and whose character is such that a reasonable degree of confidence cannot be placed in his integrity and honesty in dealing with the Government.
>
> 'The authority to pursue this course under those circumstances rests upon the very necessity that exists for its adoption as a safeguard against fraud in administering the laws relating to the settlement and payment of claims upon the United States.
>
> 'Besides, it is a just and necessary limitation upon the right of a party to be represented by an agent, and to select the agent by whom he will be represented, that he shall not employ a person offensive or dangerous to the other party with whom he is to deal.' " (Emphasis added.)

In the light of these statements of implied authority to regulate practice before Government agencies, it is clear from the words of section 487 of the Revised Statutes that it does not go beyond sanction of the exercise of this implied housekeeping power at the level of the Commissioner of Patents. Like section 161 of the Revised Statutes, section 487 does not attempt to say that "recognition" is intended to be a federal authorization to practice law relating to patents in Florida.

Section 487 authorizes the Commissioner to exercise the power of "recognition" by requiring "such persons, agents, or attorneys, before being recognized as representatives of applicants," to show "that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and are likewise competent to advise and assist applicants" in "the presentation and prosecution of their applications . . . before the office." But it does not manifest a Congressional purpose to authorize the practice of law in the patent field. Rather does § 487 show that with respect to practice *before the Patent Office* the Commissioner may exclude incompetent or disreputable persons from such practice, whether or not they are admitted to practice law in a particular State. This power of exclusion obviously complements, not supersedes, State regulation of the practice of law since it is plainly compatible with such State regulation to require practitioners before the Patent Office to evidence competence in the highly technical field of patents.

B. Practice "Before" the Patent Office Means "In The Presence of the Patent Office"

Notwithstanding that § 487 in terms does not trench on the State police power to regulate the practice of law, Petitioner and the United States would have this Court interpret "recognition" "before the Patent Office" pursuant to § 487 to constitute the affirmative grant of a federal license to practice law relating to patents anywhere in the United States. But nothing in § 487 supports this claim. For State power to admit to the Bar and the Federal power under § 487 to require special qualifications incident to practice before the

Patent Office have little if any overlap and none of a conflicting character.

Specifically, when not used in a temporal sense, the word "before" ordinarily means "*in the presence of.*" Thus "an affidavit made before a magistrate" in 18 U.S.C. § 3182 means made "in the presence of" the magistrate, *State* v. *Murnane,* (1927), 172 Minn. 401, 215 N.W. 803; *Ex parte Davis* (1933), 333 Mo. 262, 62 S.W. 2d 1086, 89 A.L.R. 589; *In re Murphy* (1947), 321 Mass. 206, 72 N.E. 2d 413. Acknowledgment of a deed by an officer over the telephone is not an acknowledgment "before" that officer required by statute, *Hutchinson* v. *Stone,* 79 Fla. 157, 84 So. 151. "In the presence of the enemy" is synonymous with "before the enemy" in a court martial specification, *Bigrow* v. *Hiatt* (D. Pa. 1947), 70 F. Supp. 826, 829. Moreover, that "before the Patent Office" necessarily means "in the presence of the Patent Office" is confirmed by the words "presentation or prosecution" which also clearly import activities "in the presence of" the Patent Office and not throughout the United States that potentially may come before the Patent Office.

C. In 1938 the Rules of the Patent Office Expressly Disclaimed Any Intention of "Authorizing Persons Not Members of the Bar to Practice Law"

The rules of practice before the Patent Office never have expressed or implied any attempt to authorize a person to practice law relating to patents in Florida or elsewhere. But since 1938 they have specifically provided or recognized that admission to practice before the Patent Office is not to be construed as author-

izing persons not members of the bar to practice law.[6] Thus, in 1938, Rule 17 of the Rules of Practice (495 O.G. 715) for the first time established a "register of attorneys" for attorneys at law, and a wholly separate "register of agents" for persons not attorneys at law, "on which will be entered the names of all persons entitled to represent applicants before the Patent Office in the presentation and prosecution of applications for patent." The purpose and significance of this separate recognition of patent lawyers and agents was made meaningful by an express provision of the rule applicable both to agents and attorneys at law:

> "Registration under the provisions of this rule **shall not be construed as authorizing persons not members of the bar to practice law.**" (Emphasis added.)

This amendment to Rule 17 is a clear administrative interpretation of § 487 of the Revised Statutes that admission to practice before the Patent Office was never intended to authorize the practice of patent law in Florida or elsewhere.

Moreover, this interpretation of § 487 was continued in 1949, when, incident to a comprehensive revision of the Rules of Practice, the portion of Rule 17 recognizing that registration "shall not be construed as author-

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[6] Prior to 1938, the rules show only an evolving power of exclusion of disruptable or incompetent lawyers or laymen from practice before the Patent Office that really began in 1898 when all persons recognized as eligible to represent inventors before the Patent Office were enrolled on a register of "patent attorneys" without regard to whether they were attorneys at law. The more significant details of this evolution are traced in the *Amicus* Brief of the American Bar Association, Appendix C.

izing persons not members of the bar to practice law" was incorporated in Rule 341 and restated as

> "Registration in the Patent Office under the provisions of these rules shall **only** entitle the persons registered to practice before the Patent Office." (29 C. F. R. § 1.341 (1949)) (Emphasis added.)

Thus this limitation continues the provision that admission to practice before the Patent Office is not to be understood as authorizing the practice of law by persons "not members of the bar." That the 1949 restatement of Rule 17 was not a substantive change is evidenced by the word "only" which states in affirmative language what Rule 17 stated in the negative. Moreover, this philosophy with respect to affirmatively disclaiming any intent to authorize the practice of law was repeated in 1955 when, acting under the successor statute to § 487 (35 U.S.C. §§ 31, 32), the Commissioner of Patents revised the rules of practice before the Patent Office in trademark cases to provide among other things that "Recognition of any person under this section is not to be construed as sanctioning the performance of any acts regarded in the jurisdiction where performed as the unauthorized practice of law." (37 C.F.R. § 2.12 (d) (1955)).

Thus we think it absolutely clear that the Patent Office itself has repeatedly disclaimed any intention to authorize any one to practice law.

D. The Legislative History of § 487 Confirms the Housekeeping Character of the Statute

The legislative history shows that Congress in enacting section 487 of the Revised Statutes, as amended in 1922, had no thought of regulating the practice of law or of authorizing the Commissioner to authorize persons to practice law relating to patents. Responding to requests of the Patent Office, Congress in 1922 was endeavoring solely to enlarge the housekeeping authority of the Commissioner to deny or refuse "recognition" on grounds in addition to "gross misconduct" previously authorized by section 487, particularly for engaging in false or misleading advertising. It sought also to give the Commissioner final administrative authority in the exercise of this power to exclude without obtaining the prior approval of the Secretary of Interior. The only reference to the practice of law was in recognition of the inability of the State Courts to prevent out of State "patent attorneys," mostly in Washington, D. C., from engaging in fraudulent advertising and in recognition of the power of the State Courts to disbar any attorney at law within a State who solicited patent business. This legislative history is set forth in Appendix C of the *Amicus* Brief of the American Bar Association.

E. Admission to Practice Before the Patent Office Does Not Entitle Petitioner to Practice Patent Law in the Federal Courts

No Federal court has recognized admission to practice before the Patent Office in patent and trademark cases as constituting eligibility to practice law with respect to such cases in the Federal courts. For example, Rule 11 of the Rules of Practice of the United

States Court of Customs and Patent Appeals expressly limits eligibility to admission to practice before that Court to "Any attorney who is entitled to practice in the Supreme Court of the United States or in the courts of appeals of the United States or in the court of last resort in any State or Territory or the District of Columbia or in the United States Court of Claims" without regard, for the purposes of the jurisdiction of that Court in patent and trademark cases, to whether the attorney has also been admitted to practice before the Patent Office. The same is true of the United States District Courts.

Thus Petitioner can not claim, by virtue of being "recognized" by the Patent Office, a right to practice law relating to patents inside the courtroom, and there is no greater basis for Petitioner to claim a right to practice law relating to patents *outside* the courtroom.

POINT SIX

IF THE STATUTE COULD BE CONSTRUED TO MEAN THAT CONGRESS HAS AUTHORIZED THE COMMISSIONER TO AUTHORIZE THE PETITIONER TO PRACTICE LAW RELATING TO PATENTS IN FLORIDA, IT WOULD BE INVALID AS AN IMPROPER DELEGATION OF LEGISLATIVE POWER

First, Congress has no power to authorize people to practice law. Any attempt by Congress to authorize people to practice law in the federal field would be an invasion of the judicial power vested in this court. See Point Four, *supra*, p. 46.

Second, however, if we should assume, for purposes of argument that Congress has the power to authorize people to practice law in the federal field, nevertheless, as set forth in Point Five, *supra*, p. 49. Congress has never attempted to authorize the Commissioner of Patents to authorize the Petitioner to practice law relating to patents in Florida. The statute in question is a mere housekeeping statute designed to exclude undesirable persons from "recognition" by the Patent Office. Dealing solely as it does with "recognition" by the Patent Office, it does not purport to confer any right whatever to practice law relating to patents in Florida.

Third, if we should assume, for the purpose of argument, that this statute could be interpreted to mean that Congress has attempted to authorize the Commissioner of Patents to authorize Petitioner to practice law relating to patents in Florida, to that extent the statute would be invalid for the additional reason that it would be an unconstitutional delegation of legislative power.

Here it is significant that in 1938 the Rules of Practice of the Patent Office were amended to provide, with respect to both "attorneys" and agents, that

> "Registration under the provisions of this rule *shall not be construed as authorizing persons not members of the bar to practice law.*" (Emphasis added.)

Later, the Rules were amended to provide that

> "Registration in the Patent Office shall *only* entitle the persons registered to practice before the Patent Office." (Emphasis added.)

The foregoing provisions are in complete harmony with the decision below enjoining Petitioner from certain acts in Florida which constituted the practice of law.

Now, however, Petitioner contends that the Rules of Practice give him a federal license to do the precise thing that they have categorically prohibited him from doing beginning in 1938. Stated otherwise, in 1938 the Rules of Practice specifically provided that "Registration . . . shall not be construed as authorizing persons not members of the bar to practice law." Now Petitioner claims that the Rules specifically authorize him to engage in the practice of law relating to patents in Florida. And no particular reason appears as to why he should be prohibited in one year and permitted in another year, with respect to the very same act.

But if we can assume the construction of the statute contended by Petitioner, the first significant feature of this from the standpoint of delegation of legislative power is that the "practice of law" as the *subject* of any such delegation by Congress is not even mentioned, let alone "defined" in the statute. Second, there is a

complete absence of *standards*[7] laid down by Congress as to when, how or whether the Commissioner of Patents may authorize and when he may prohibit laymen to practice law relating to patents in one of the states. Accordingly, Petitioner contends that if today the Commissioner feels that it is a good idea to prohibit laymen from engaging in the practice of law relating to patents, he can promulgate a rule saying so. If tomorrow, he decides that such is not a good idea, he can promulgate a contrary ruling permitting layman to practice law relating to patents in every State. In short, the very thrust of the Petitioner's claim is that the Commissioner of Patents may permit or prohibit laymen from practicing law or license them to practice law, *as he pleases*, in the complete absence of any standards laid down by Congress defining when, whether or how laymen should be permitted to practice law. This would be conferring an unfettered discretion upon a Government official—something not permitted by our system of government.

That this would be unlawful is well settled by the cases. First, it is clear that, in order to validly delegate legislative power, the "*subject to which this authority relates*" must be "*defined.*" Thus in *Panama Refining Co.* v. *Ryan* (1935), 293 U.S. 388, 79 L. Ed. 446, 55 S. Ct. 241, the Court, among other things, said:

> "Fourth. Section 9(c) is assailed upon the ground that it is an unconstitutional delegation of legislative power. The section purports to authorize the President to pass a prohibitory law.

[7] Such standards as appear in the statute relate solely to criteria under which the Commissioner may *exclude* unsuitable persons from representing applicants before the Patent Office, as distinguished from standards appropriate to the exercise of a power to authorize persons to practice law relating to patents.

> ***The subject to which this authority relates is defined.*** It is the transportation in interstate and foreign commerce of petroleum and petroleum products which are produced or withdrawn from storage in excess of the amount permitted by state authority. Assuming for the present purpose, without deciding, that the Congress has power to interdict the transportation of that excess in interstate and foreign commerce, the question whether that transportation shall be prohibited by law is obviously one of legislative policy. Accordingly, we look to the statute to see whether the Congress has declared a policy with respect to that subject; whether the Congress has set up a standard for the President's action; whether the Congress has required any finding by the President in the exercise of the authority to enact the prohibition. (293 US 414, 415.) (Emphasis added.)

In the instant statute, however, there is no mention whatever of the "subject" of authorizing anyone to "practice law" relating to patents in Florida or elsewhere.

Second, it is also clear that the question as to whether and how the subject is to be regulated—once it is defined—"is obviously one of legislative policy." See the quotation from the *Panama* case immediately above. The statute must be scrutinized to see, first, whether Congress has declared a policy with respect to the subject defined, and second, whether the Congress has set up *standards* for the action of the delegate. *Panama Refining Co.* v. *Ryan* (1935), 293 US 388, 79 L. Ed. 446, 55 S. Ct. 241, *supra*, A. L. A. *Schechter Poultry Corp.* v. *United States* (1935), 295 US 495, 79 L. Ed. 1570, 55 S. Ct. 837, 97 A. L. R. 947.

The question presented, and the holding of the *Schechter* case that section 3 of the National Industrial

Recovery Act was an unconstitutional delegation of legislative power are set forth below:

> "Second. The question of the delegation of legislative power. We recently had occasion to review the pertinent decisions and the general principles which govern the determination of this question. *Panama Ref. Co.* v. *Ryan,* 293 U.S. 388, ante, 446, 55 S. Ct. 241. The Constitution provides that 'all legislative powers herein granted shall be vested in a Congress of the United States, which shall consist of a Senate and House of Representatives.' Art. 1, § 1. And the Congress is authorized 'to make all laws which shall be necessary and proper for carrying into execution' its general power. Art. 1, § 8, Par. 18. The Congress is not permitted to abdicate or to transfer to others the essential legislative functions with which it is thus vested." (295 US 529).
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> * * * * *
>
> "To summarize and conclude upon this point: § 3 of the Recovery Act is without precedent. It supplies no standards for any trade, industry or activity. It does not undertake to prescribe rules of conduct to be applied to particular states of fact determined by appropriate administrative procedure. Instead of prescribing rules of conduct, it authorizes the making of codes to prescribe them. For that legislative undertaking, § 3 sets up no standards, aside from the statement of the general aims of rehabilitation, correction and expansion described in § 1. In view of the scope of that broad declaration, and of the nature of the few restrictions that are imposed, *the discretion of the President* in approving or prescribing codes, and thus enacting laws for the government of trade and industry throughout the country, *is virtually unfettered.* We think that the code-making authority thus conferred is an unconstitutional delegation of legislative power." (295 US 541, 542). (Emphasis added.)

Again, in the instant case, if we could assume that the statute could be construed to mean that Congress intended to authorize the Commissioner to authorize the Petitioner to practice law relating to patents in Florida, there is a complete absence of standards as to how, whether or when the Commissioner should authorize the Petitioner to practice law. There would be a conferring of an unfettered discretion on the Commissioner. As Justice Cardoza put it, concurring in the *Schechter* case, "*This is delegation running riot.*" 295 U.S. 553.

POINT SEVEN

IF THE STATUTE COULD BE CONSTRUED TO AUTHORIZE THE COMMISSIONER TO AUTHORIZE THE PETITIONER TO PRACTICE PATENT LAW IN FLORIDA, IT WOULD ALSO EXCEED THE POWERS CONFERRED ON THE FEDERAL GOVERNMENT IN THE CONSTITUTION AND INVADE THE POWERS RESERVED TO THE STATES BY THE TENTH AMENDMENT.

A. Introduction

First, we have shown above in Point Four, *supra*, p. 46, that where the judicial power of government is vested in the Courts, as it is in the Constitution of the United States, only the Courts have the power to admit to the Bar and to disbar, and have the power to define what constitutes the practice of law and to exclude unauthorized persons therefrom. The legislative branch—Congress—has no power to authorize persons to practice law, in the federal field or elsewhere.

Second, however, for purposes of argument only, and contrary to Point Four, we are assuming in this point that Congress could authorize people to practice law. And third, we also assume for purposes of argument only and contrary to Point Five, *supra*, p. 49, that the statute in question could be construed to mean that Congress attempted to authorize the Commissioner to authorize the Petitioner to practice law in Florida. Fourth we further assume, contrary to Point Six, *supra*, p. 60, again for purposes of argument only, that the statute, so construed, could be held to be a constitutional delegation of legislative power despite the fact that the practice of law is not even mentioned as the "subject" of any attempted delegation, and there is a complete absence of standards as to whether, when or how, or on what basis, the Commissioner should authorize people to practice law.

Only on the basis of these three assumptions do we proceed to this point.

B. Except for the Protection of An Inventor's Right to a Patented Invention, the Patent Clause of the Constitution and the Patent Laws Passed by Congress Are Subject to the Police Power of the States.

Petitioner (brief, p. 27) quotes from *McClurg* v. *Kingsland* (1843), 1 How. 202, 206, 11 L. Ed. 102, 103, to the effect that "the powers of Congress to legislate upon the subject of patents is plenary," but omits the context in which the statement was made. The full paragraph involved is as follows:

> "The exceptions to the charge were confined to these two points, which constitute the only subject for our consideration. Whether these exceptions are well taken or not *must depend on the law as it stood at the emanation of the patent, together with such changes as have been since made;* for though they may be retrospective in their operation, that is not a sound objection to their validity; *the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution,* and as there are no restraints on its exercise, *there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents.*" (1 Howard 206.)

So we see that *McClurg* v. *Kingsland* did not involve State-Federal relations in the field of patents, as is implied by Petitioner in his brief, p. 27. Rather, it was a suit brought by the assignees, McClurg, *et al.*, of an inventor, Harley, against Harley's former employer, Kingsland, for infringement of a patent. The trial Court had submitted the case to the jury on a charge that the facts presumed a license to Kingsland, to use the patent. Harley had developed the invention while employed by Kingsland, had given him free use of it before an application for a patent was made, and had been given an increase in wages for making the

invention. The case itself turned upon the consolidated effect of successive acts of Congress relating to the particular patent. And it appears to be plain that, when this Court said "the powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution . . . there can be no limitation on their right to modify them, so long as they do not take away the rights of property in existing patents," this Court was discussing only the right of Congress to legislate, and amend its legislation, *with respect to the particular patent in question*, and as between employer and employee. It was not discussing relations between the State and Federal Governments.

But there are significant cases in the field of Federal-State accommodation relating to patents. Probably the leading case is *Patterson* v. *Kentucky* (1879), 97 US 501, 24 L. Ed. 1115. That case analyzed the substance, scope and limits of the power conferred by the States on the Federal Government in Article I, Section 8, Clause 8, which only provides that:

> "The Congress shall have Power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

It is to be noted that this clause of the Constitution does not mention the word "patents," and that, grammatically, the only "power" conferred is to promote science, etc., "*by securing* for limited times to authors and inventors *the exclusive right* to their respective writings and discoveries." (Emphasis added.) Thus the vitals of the power conferred, in our context, is to "*secure . . . the exclusive right to . . . discoveries.*" The word "secure" means "protect." *Wheaton* v. *Peters* (1834), 8 Pet. 591, 8 L.Ed. 1055; *Patterson* v.

Kentucky (1879) 97 U.S. 501, 506, 24 L.Ed. 1115; *Webber* v. *Virginia* (1881) 103 U.S. 344, 349, 26 L.Ed. 565. Nothing more was granted by the States, in this connection, to the Federal Government. In contrast to the commerce power, for instance, no broad power such as the power to "regulate discoveries and patents therefor, and the use thereof," was granted.

So in *Patterson* v. *Kentucky*, the Court of Appeals of Kentucky had affirmed a judgment imposing a fine of $250 for violation of a Kentucky statute prohibiting, with criminal penalties, the sale of certain oils which burned at temperatures considered unsafe for illuminating purposes. The plaintiff in error had manufactured the oil in question, known as "Aurora" oil in accordance with letters patent issued to her assignor. Accordingly, she claimed that "she had the right to sell the Aurora oil in any part of the United States, and that no State could, consistently with the Federal Constitution and the laws of Congress prevent or obstruct the exercise of that right . . ." by passing laws "to which the patented article could not be made to conform."

In affirming the judgment below, this Court had a number of significant things to say with respect to the limited scope of the power conferred:

> "Congress is given power to promote the progress of science and the useful arts. To that end it may, by all necessary and proper laws, secure to inventors, for limited times, the exclusive right to their discoveries. That power has been exerted in the various statutes prescribing the terms and conditions upon which inventors may obtain letters patent. It is true that *letters patent, pursuing the words of the statute, do, in terms grant to the inventor, his heirs and assigns, the exclusive right to make, use and vend to others his invention or discovery*, throughout the United States and the

Territories thereof. *But, obviously, this is not granted to or secured, without reference to the general powers which the several States of the Union unquestionably possess* in reference to their purely domestic affairs, whether of internal commerce or of police." (Emphasis added.) (97 U.S. 503.)

* * * * *

"The Kentucky statute being, then, an ordinary police regulation for the government of all engaged in the internal commerce of that State, the only remaining question is, whether under the operation of the Federal Constitution and the laws of Congress, it is without effect in all cases where the oil, although condemned by the State as unsafe for illuminating purposes, has been made and prepared for sale in accordance with a discovery for which letters patent have been granted. We are of opinion that *the right conferred upon the patentee and his assigns to use and vend the corporeal thing or article, brought into existence by the application of the patented discovery, must be exercised IN SUBORDINATION TO the police regulations which the State has established by the Statute of 1874.*" (Emphasis added.) (97 U.S. 505.)

* * * * *

"These considerations, gathered from the former decisions of this court, would seem to justify the conclusion that *the right which the patentee or his assignee possesses in the property, created by the application of a patented discovery, must be enjoyed subject to the complete and salutary power with which the States have never parted,* of so defining and regulating the sale and use of property within their respective limits as to afford protection to the many against the injurious conduct of the few." (Emphasis added.) 97 U.S. 506.)

* * * * *

"*The right which the patent primarily secures is the exclusive right in the discovery*, which is an incorporeal right, or, in the language of Lord Mansfield, in Millar v. Taylor, 4 Burr., 2303, 'a property in notion,' which 'has no corporeal tangible substance.' *The enjoyment of that incorporeal right may be secured and protected by national authority against all hostile state legislation;* but the tangible property which comes into existence by the application of the discovery is not beyond the control as to its use of state legislation, simply because the inventor acquires a monopoly in the discovery.

"An instructive case upon the precise point under consideration is *Jordan* v. *Overseers of Dayton*, 4 Ohio 295. Jordan was sued in debt, to recover certain penalties for practicing medicine in violation of an Ohio Statute regulating the practice of physic and surgery. His defense rested, in part, upon the ground that the medicine administered by him was that for which letters patent had issued to his assignor, granting to the latter the exclusive right of making, constructing, using and vending to others to be used, the medicine in question, which was described in the letters patent as a new and useful improvement, and as being a mode of preparing, mixing, compounding, administering and using that medicine. The contention of Jordan was, that the State Government could not restrict or control the beneficial or lucrative use of the invention; and that, as assignee of the patentee, he was entitled to administer the patented medicine *without obtaining a license to practice physic or surgery as required by the state Statute*. The Supreme Court of Ohio said: 'This leads us to consider the nature and extent of such rights as accrue from letters patent for useful discoveries.'" (Emphasis added.) (97 U.S. 506, 507.)

* * * * *

"'*If the State should pass a law for the purpose of destroying a right created by the Constitution, this court will do its duty; but an attempt by the Legislature, in good faith, to regulate the conduct of a portion of its citizens*, in a matter strictly pertaining to its internal economy, we cannot but regard as a legitimate exercise of power, *although such law may sometimes indirectly affect the enjoyment of rights flowing from the Federal Government.*'"

* * * * *

"In the case of *Livingston* v. *Van Ingen*, 9 Johns., 507, Chancellor Kent said that 'The national power will be fully satisfied if the property created by patent be, for the given time, enjoyed and used exclusively, so far as, under the laws of the several States, the property shall be deemed [fit] for toleration [and use]. There is no need of giving this power any broader construction in order to attain the end for which it was granted, which was to reward the beneficent efforts of genius, and to encourage the useful arts.'"

* * * * *

"Without further elaboration, we deem it only necessary to say that the *Kentucky Statute does not, in our judgment, contravene the provisions of the Federal Constitution, or of any statute passed in pursuance thereof. Its execution creates no necessary conflict with national authority, and interferes with no right secured by federal legislation*, to the patentee or his assigns." (Emphasis added.) (97 US 509.)

The Ohio case of *Jordan* v. *Overseers of Dayton*, relied upon by this Court in *Patterson* v. *Kentucky*, is specially pertinent to the case at bar. Indeed, it was an unauthorized practice case. There Jordan was sued for certain penalties for having violated the prohibition against the unauthorized practice of medicine.

His defense was that he was administering certain patent medicine and was entitled to do so "*without obtaining a license to practice physic and surgery as required by the state statute.*" Moreover, in the Ohio Supreme Court Jordan had insisted that

> "the power of the legislature is limited in this case because the patent, securing to Thompson [the plaintiff's assignor] the exclusive right of preparing and mixing medicines, emanated from the general government, under the authority of the constitution; and that its full effect cannot be had, unless it be holden altogether exempt from the state control."

But the Ohio Supreme Court overruled this defense on the ground that the patent power confered by the Constitution was only "indirectly affected" (97 US 508) by and subject to the right of the State, in the exercise of its police power, to regulate the practice of medicine in Ohio, with the approval of this Court. And just as in that case the patent clause of the Constitution and the laws passed by Congress pursuant thereto were held subject to the police power of the State to regulate the practice of medicine, so in this case they are subject to the police power of the State to regulate the practice of law.

Also, in *Webber* v. *Virginia* (1881) 103 US 344, 26 L. Ed. 565, Webber had been convicted for unlawfully selling and offering for sale certain Singer Sewing Machines without having first obtained a license for that purpose. Thus, the question was whether the State could require a *license* for the sale of articles which had been patented. One of Webber's defenses was that the Singer Manufacturing Company held a patent of the United States, "authorizing it to manu-

facture and sell them anywhere in the United States." (page 347). In holding that there was no error in overruling this defense, this Court pointed out that "The combination of different materials . . . which constitutes the invention or discovery, cannot be forbidden by the State," but indicated that the Constitution does not confer any general right on the Federal Government to regulate anything and everything that happens to be connected with "patents." Instead, the Constitution only conferred very limited power, that is, only power with respect to "the right to the invention or discovery, the incorporeal right" and that that was the only right with which the State could not interfere. Otherwise, however, the Court pointed out that "*Congress never intended that the patent laws should displace the police powers of the states,*" and that, except with respect to the right to the invention or discovery, whatever rights are secured to inventors under the patent laws of the United States must be enjoyed "*in subordination to*" the police power of the States. Thus this Court, among other things, said:

> "The patent for a dynamite powder does not prevent the State from prescribing the conditions of its manufacture, storage and sale, so as to protect the community from the danger of explosion. A patent for the manufacture and sale of a deadly poison does not lessen the right of the State to control its handling and use. The legislation respecting the articles which the State may adopt after the patents have expired, it may equally adopt during their continuance. **It is only the right to the invention or discovery, the incorporeal right, which the State cannot interfere with. Congress never intended that the patent laws should displace the police powers of the States,** meaning by that term those powers by which the health, good order, peace and general welfare of the com-

munity are promoted. *Whatever rights are secured to inventors* must be enjoyed *in subordination* to this general authority of the State over all property within its limits." (Emphasis added.) (103 US 347-348.)

* * * * *

"In accordance with the views thus expressed, we can find no objection to the legislation of Virginia *in requiring a license for the sale of the sewing-machines*, by reason of the grant of letters patent for the invention." (Emphasis added.) 103 US 349.)

In another, perhaps even more significant case, *Allen* v. *Riley* (1906), 203 US 347, 51 L. Ed. 216, 27 S. Ct. 105, this Court upheld a Kansas statute which required one selling a patent right in any county in that state to file with the Clerk in such county an authentic copy of the letters patent, together with an affidavit of genuineness of the letters patent and as to other matters. And this was in the very face of a Federal statute which regulated the same subject matter. It provided that a patent or interest therein shall be assignable in law by an instrument in writing, which assignment is to be void against any subsequent purchaser or mortgagee without notice unless recorded in the Patent Office within three months from the date thereof.

What happened was that the plaintiff in the trial court sued to recover the value of certain lands alleged to have been transferred by him to the defendant in part payment for the transfer to the plaintiff of certain rights under a patent for a washing machine. The right to recover was based upon the failure of defendants to comply with the Kansas statute. In turn, the defendants insisted that the Kansas statute in question violated the patent clause of the Constitu-

tion "*and the Federal statute passed in pursuant thereof,*" Revised Statutes, Section 4898.

It was asserted by the defendants in the trial court that the subject of the sale or assignment of an interest in a patent "is derived from the laws of Congress passed with reference to the constitutional provision quoted above, and that any regulations whatever, by any state authority, in regard to such assignment or sale, and making provision in respect to them, are illegal."

However, the Supreme Court of Kansas upheld the Kansas statute and affirmed a judgment for plaintiff. And on writ of error to this Court, the judgment was affirmed and the Kansas statute upheld. After discussing *Patterson* v. *Kentucky, supra*, this Court had the following to say regarding *Webber* v. *Virginia, supra:*

> "*Webber* v. *Virginia, supra,* relates also to tangible property covered by a patent, and it was held that the patent did not exclude from the operation of the taxing or licensing law of the state the tangible property manufactured under a patent. It was said in that case that 'Congress never intended that the patent laws should displace the police powers of the states,' meaning by that term those powers by which the health, good order, peace, and general welfare of the community are promoted. Whatever rights are secured to the inventors must be enjoyed in subordination to this general authority of the state over all property within its limits."

This Court then proceeded to uphold the statute in the following language:

> "We think the state has the power (certainly until Congress legislates upon the subject) with

regard to the provision which shall accompany the sale or assignment of rights arising under a patent, *to make reasonable regulations concerning the subject, calculated to protect its citizens* from fraud. And we think Congress has not so legislated by the provisions regarding an assignment contained in the act referred to."

* * * * *

It is noteworthy that when this Court remarked that "the State has the power (certainly until Congress legislates upon the subject) with regard to the provision which shall accompany the sale or assignment of rights arising under a patent," this Court was dealing with the very subject of Constitutional power—the "exclusive right" to an invention. But to repeat, in our case there is no Congressional legislation relating any real relation to that subject, and nothing relating thereto with which the decision below could be said to interfere.

The Court further said:

> "To uphold this kind of a statute is by no means to authorize any state to impose terms which, possibly, in the language of Mr. Justice Davis, in Ex parte Robinson, 2 Biss. 309, Fed. Cas. No. 11,932, 'would result in a prohibition of the sale of this species of property within its borders, and in this way nullify the laws of Congress which regulate its transfer, and destroy the power conferred upon Congress by the Constitution.' Such a statute would not be a reasonable exercise of the powers of the state." (Emphasis added.)

The last quotation is particularly significant. It points out that the State could not prohibit "the sale of this species of property," by "property" meaning a patent. In short, the Constitution protects the exclu-

sive right of the inventor to the patent, and the State could not prohibit the sale thereof. But, as the Court held, it may "make *reasonable regulations concerning*" the sale or assignment thereof.

Finally, the Court concluded, significantly, that:

> "The mere provision in the Federal statute for an assignment and its record as against subsequent purchasers, etc., *is not such legislation as takes away the rights of the states to legislate on the subject themselves in a manner neither inconsistent with, nor opposed to, the Federal statute.* We think the judgment is right, and it is affirmed." (Emphasis added.)

In *Long* v. *Rockwood* (1928), 277 U.S. 142, 72 L. Ed. 145, 84 S. Ct. 461, this Court held that a State could not tax royalties for the use of patents issued by the United States. Justice Holmes, Brandeis, Sutherland, and Stone, however, dissented, in a cogent opinion which, among other things, said:

> "Even with regard to patents some laws of a kind that might destroy the use of them within the state have been upheld. *Patterson* v. *Kentucky*, 97 U.S. 501, 24 L. ed. 1115; *Webber* v. *Virginia*, 103 U.S. 344, 26 L. ed. 565; *Emert* v. *Missouri*, 156 U.S. 296, 39 L. ed. 430, 5 Inters. Com. Rep. 68, 15 Sup. Ct. Rep. 367. They must be reasonable or they will be held void, but if this court deems them reasonable they stand. *Allen* v. *Riley*, 203 U.S. 347, 355, 51 L. ed. 216, 218, 27 Sup. Ct. Rep. 95, 8 Ann. Cas. 137."

Long v. *Rockwood* has now been overruled by *Fox Film Corp.* v. *Royal* (1932), 286 U.S. 123, 76 L. Ed. 1010, 52 S. Ct. 542, thus giving added significance to the potent language quoted above from the opinion by Mr. Justice Holmes. And the limited interest of

the United States under the patent and copyright clause is mentioned in the opinion by Chief Justice Hughes in the *Fox Film* case, upholding a State tax on the gross receipts of royalties of licenses for copyrighted motion pictures, as follows:

> "*The sole interest of the United States and the primary object* in conferring the monopoly lie in the general benefits derived by the public from the labors of authors. A copyright, like a patent, is 'at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals and the incentive to further efforts for the same important objects.' Kendall v. Winsor, 21 How. 327, 328, 16 L.ed. 167, 168; Grant v. Raymond, 6 Pet. 218, 241, 242, 8 L. ed. 376, 384, 385. (Page 1014) (Emphasis added.)

The scope of the patent clause of the Constitution was also held to be limited in *Crown Die & Tool Company* v. *Nye Tool & Machine Works*, 261 U.S. 24, 67 L. Ed. 516, 43 S. Ct. 254. There the Plaintiff sued to enjoin the alleged infringement of a patent. In the course of an opinion by Chief Justice Taft the Court had occasion to analyze the scope of the power granted to Congress by Article 1, Clause 8, and among other things said:

> "The analysis of the rights which a patentee acquires under the grant is sustained by a line of authorities."
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> * * * * *
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> "The fullest and most satisfactory discussion of the subject is found in the Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 US 405, 52 L. ed. 1122, 28 Sup. Ct. Rep. 748."
>
> * * * * *

"The court held that the government did not confer on the patentee the right himself to make, use, or vend his own invention, that such right was a right under the common law, not arising under the Federal Patent Laws, *and not within the grant of power to Congress to enact such laws.*" (Emphasis added.)

* * * * *

C. Even With Respect to an Inventor's Exclusive Right to an Invention, the State May Make "Reasonable Regulations" Concerning It

We think it clear that our case does not involve any interference with "securing," or "protecting," an inventor's "exclusive right" to an invention. But even if it did, *Allen* v. *Riley*, and Mr. Justice Holmes' opinion in *Long* v. *Rockwood*, *supra* in B above, make it perfectly clear that "reasonable regulations" of even that subject by the States in the exercise of the police power, will be sustained.

D. Even a Broad Grant of Power Such as the Power of Congress to Regulate Interstate Commerce, Can Be "Burdened" by the Police Power to Some Extent

The grant of power relating to "securing . . . the exclusive right to . . . discoveries," by the States to the Federal government, is narrow and limited. In this context the word "securing" appears to mean "shielding" or "guarding" . . . the exclusive right to . . . discoveries. (Webster's Dictionary.) This is in great contrast to the broad grant of power to the Federal government to "regulate" interstate and foreign commerce. Indeed, the very use of the word "regulate" imports a sweeping power of control not even hinted at in the narrow verb "securing" . . . the exclusive right to . . . "discoveries." For the word "regulate" means

that Congress can "fix, establish, or control; to adjust by rule, method or established mode; to direct by rule or restriction; to subject to governing principles or laws." *Black's Law Dictionary*, 4th Edition, Page 1451. See *United States* v. *Darby*, 312 U.S. 100, 85 L. Ed 609, 61 S. Ct. 451, 132 A.L.R. 1430.

Accordingly, with this vast gulf between the meaning of these two very different words, one might think that, while the States can reasonably regulate everything in the exercise of the police power, apart from the right to the invention itself, under the patent laws, they could not affect interstate commerce at all. The contrary, however, is true. Even the broad commerce power conferred upon the Federal government may be "burdened" or indirectly affected to some extent.

This is concisely summarized in *Huron Portland Cement Company* v. *the City of Detroit* (1960), 362 U.S. 440, 4 L. Ed. 2d 852, 80 S. Ct. 813. In that case a corporation engaged in operating federally licensed steam vessels in interstate commerce sought to enjoin the enforcement against it of provisions of the Smoke Abatement Code of the City of Detroit under which the Corporation's steam vessels could not, without undergoing structural alterations, perform necessary cleaning of their fires within the city. The Michigan Supreme Court affirmed a judgment for the defendant, and on appeal that judgment was affirmed by this Court. This Court held that the intent to supersede the exercise by the State of its police power as to matters not covered by Federal legislation is not to be inferred; and that the object of the Federal inspection statute was different from the aim of the Detroit ordinance. The purpose of the Federal inspection statutes was to insure the seagoing safety of vessels

subject to inspection, while the aim of the Detroit ordinance was the elimination of air pollution. This Court held that the Federal inspection legislation had not at all pre-empted local action, and repeated the admonition of earlier cases that conflicts between state and Federal regulation are not to be sought out where they do not clearly exist. And finally this Court held that the mere possession of a Federal license "does not immunize a ship from the operation of the normal incidents of local police power not constituting a direct regulation of commerce." Mr. Justice Stewart's opinion concluded:

* * * * *

"*We cannot hold that the local regulation so burdens the federal license as to be constitutionally invalid.*" (Emphasis added.)

* * * * *

E. Cases Relied on by Petitioner Do Not Support Its Position

The cases of *Leslie Miller, Inc.* v. *Arkansas* (1956) 352 US 187, 1 L. Ed. 2d 231, 77 S.Ct. 257, and *Johnson* v. *Maryland* (1920) 254 U.S. 51, 65 L. Ed. 126, 41 S. Ct. 16, do not support Petitioner's position. Both cases dealt with "the immunity of the instruments of the United States from state control" (352 U.S. 190), something which cannot be said to be present in our case. In addition, in *Leslie Miller* v. *Arkansas*, the State had imposed license requirements which "would give the State's licensing board a virtual power of review over the federal determination of 'responsibility' and would thus frustrate the expressed federal policy of soliciting the lowest responsible bidder." In the instant case, however, the requirements with respect to "recognition" of persons by the Patent Office, and those of The Florida Bar with respect to the administration of

justice by control of the Courts over the practice of law, relate to wholly different subject matter. The State of Florida has not exerted any "powers of review" over any "federal determination," and no "expressed federal policy" has been "frustrated."

Kingsland v. *Dorsey* (1950) 338 U.S. 318, 94 L. Ed. 123, 70 S. Ct. 123, does not support Petitioner's position. Unlike Petitioner, Dorsey was a lawyer, and was disbarred by the Patent Office. His disbarment was upheld by this Court. Petitioner quotes (brief p. 34) from the decision, p. 319, but omits to state that the quotation given related to a *lawyer* practitioner before the Patent Office. Moreover, it is obvious that Dorsey could have been the subject of separate disciplinary proceedings in the jurisdiction of his admission to the Bar. Petitioner can scarcely claim that Dorsey's disbarment would prevent the bringing of disciplinary proceedings in such jurisdiction or would be *res judicata* therein. Thus the case shows how different are the two subjects of (a) admission of a person to a State Bar, and (b) "recognition" by the Patent Office.

POINT EIGHT

THE NECESSARY EFFECT OF PETITIONER'S CLAIM IS TO SEEK TO INJECT A HOST OF LAY PRACTITIONERS INTO THE PRACTICE OF LAW THROUGHOUT THE STATES TO "THWART THE CONTROL OF THE COURTS OVER THE PRACTICE OF LAW AND IRREPARABLY IMPAIR THE SOUND ADMINISTRATION OF JUSTICE."

The brief of the United States (p. 3-5) contains more than a hint of the tremendous disruption of the practice of law and the administration of justice in the various States which is the essence of Petitioner's claim. For its necessary thrust is that other laymen would claim that they, too, have federal licenses to practice law in some field of law in every State of the Union. Thus laymen admitted to practice before various administrative agencies might claim that, in every State, they now have federal licenses to practice tax law, transportation law, government contract law, probate, etc. law relating to veterans, immigration law, social security law, agricultural law, banking law, labor law, federal power and natural gas law, tariff law, etc. This would destroy the practice of law as a seamless web, decimate the legal profession, "thwart the control of the Courts over the practice of law, and irreparably impair the sound administration of justice," to quote Chief Justice Vanderbilt in *Stack* v. *P. G. Garage, Inc.* (1951), 7 N.J. 118, 80 A. 2d 545, 547. See also *Theard* v. *United States* (1957), 354 U.S. 278, 1 L. Ed. 2d 1342, 77 S. Ct. 1274.

POINT NINE

PRESERVING THE INTEGRITY OF THE LEGAL PROFESSION AND THE PRACTICE OF LAW BY QUALIFIED PERSONS IS A MATTER OF VITAL CONCERN TO THE PUBLIC. A STRONG BAR IS POSITIVELY ESSENTIAL TO THE PUBLIC WELFARE.

It is a fact of no small significance that one of the first acts of dictators such as Hitler, Mussolini and Castro, upon assuming office, is to decimate the legal profession. And with the decimation of the Bar, there also disappears that protection of the public which the Bar affords. In particular, there could be no real protection of civil rights in the absence of a strong Bar.

For a strong bar is itself positively essential to the public welfare. It is the American lawyer who is the bulwark of individual rights in our country, whether these be denominated human rights or property rights. It is he who is the protector of the citizen against oppression, whether from a neighbor or from the government. If the practice of law is to be whittled away, chip by chip, and turned over to laymen and lay agencies, then the public will no longer have the protection which a strong bar affords, and the public will suffer.

In the leading case of *Rhode Island Bar Ass'n* v. *Automobile Service Ass'n* (1935), 55 R. I. 122, 179 A. 139, where the defendants were held in contempt of court for unlawfully practicing law, the Court, among other things, said:

> "*The bar is an important element of our judicial system*, and all of its members are obligated to govern their professional conduct in full accord with the solemn responsibility which that entails. Under our system of law the most effective guaranty of equal justice to all in the commonwealth is a competent and learned bar composed of men

of high personal character who govern their professional conduct at all times by the well known and generally accepted canons of legal ethics. The lack of such a bar, or the coexistence with it of an array of individuals or groups operating under deceptive devices and catch-names to mislead the public into the belief that they are intrusting their causes to those learned in the law and competent to serve them, would inevitably result in a deprivation of justice to many in the state. In such an atmosphere, there would be a strong tendency for the bar to sink to the level of its unauthorized and unqualified competitors. (Emphasis added)

As was cogently summarized in *West Virginia State Bar* v. *Earley* (1959), 144 West Va. 504, 109 S. E. 2d 420, 435, *supra:*

"[21, 22] The justification for excluding from the practice of law persons who are not admitted to the bar and for limiting and restricting such practice to licensed members of the legal profession is not the protection of the members of the bar from competition or the creation of a monopoly for the members of the legal profession, but instead the protection of the public from being advised and represented in legal matters by unqualified and undisciplined persons over whom the judicial department of the government could exercise slight or no control. Chicago Bar Association v. United Taxpayers of America, 312 Ill. App. 243, 38 N. E. 2d 349; Lowell Bar Association v. Loeb, 315 Mass. 176, 52 N. E. 2d 27; In re Shoe Manufacturers Protective Association, Inc., 295 Mass. 369, 3 N. E. 2d 746; State ex rel. Wright v. Barlow, 132 Neb. 166, 271 N. W. 282; New Jersey State Bar Association v. Northern New Jersey Mortgage Associates, 22 N. J. 184, 123 A. 2d 498; People v. Alfani, 227 N. Y. 334, 125 N. E. 671; State ex rel. Daniel v. Wells, 191 S. C. 468, 5 S. E. 2d 181. The admission to membership in the legal

profession is a privilege granted in the interest of the public to those who are morally fit and mentally qualified for the sole purpose of protecting the unwary and the ignorant from injury at the hands of persons unskilled or unlearned in the law. Tumulty v. Rosenblum, 134 N. J. L. 514, 48 A. 2d 850. The licensing of lawyers is not designed to give rise to a professional monopoly but instead to serve the public right to protection against unlearned and unskilled advice and service in relation to legal matters. Auerbacher v. Wood, 142 N. J. Eq. 484, 59 A. 2d 863. The reason for the requirement that the practice of law be engaged in only by duly licensed practitioners of the law is to establish and maintain a legal standard by which the rights of persons may not be jeopardized or sacrificed by counsel and advice of unlicensed and incompetent persons who give or attempt to give legal advice, prepare documents and pleadings, file and prosecute proceedings and examine witnesses in courts or other tribunals. State ex rel. Hunter v. Kirk, 133 Neb. 625, 276 N. W. 380. *It is essential to the administration of justice and the proper protection of society that* unlicensed persons be not permitted to prey upon the public by engaging in the practice of law. Clark v. Austin, 340 Mo. 467, 101 S. W. 2d 977. The reason laymen are forbidden to engage in the practice of law is that it is detrimental to the public interest for them to represent themselves to the public that they are qualified to do so when in fact they are not so qualified. Liberty Mutual Insurance Company v. Jones, 344 Mo. 932, 130 S. W. 2d 945, 125 A. L. R. 1149.

"In In re Opinion of the Justices, 279 Mass. 607, 180 N. E. 725, 81 A. L. R. 1059, the court said: '*It is indispensable to the administration of justice* and the interpretation of the laws that there be members of the bar of sufficient ability, adequate learning and sound moral character. This arises

from the need of enlightened assistance to the honest, and restraining authority over the knavish, litigant. It is highly important, also, that the public be protected from incompetent and vicious practitioners, whose opportunity for doing mischief is wide. It was said by Cardozo, C. J., in People ex rel Karlin v. Culkin, 248 N. Y. 465, 470-471, 162 N. E. 487: "Membership in the bar is a privilege burdened with conditions." One is admitted to the bar "for something more than private gain." He becomes "an officer of the court, and, like the court itself, an instrument or agency to advance the ends of justice. His co-operation with the court" is due "whenever justice would be imperiled if co-operation was withheld." Without such attorneys at law the judicial department of government would be hampered in the performance of its duties. That has been the history of attorneys under the common law, both in this country and in England. 'See also Meunier v. Bernich, (La. Court of Appeal), 170 So. 567." Emphasis added)

In *State* v. *Perkins* (1934), 138 Kan. 899, 28 P. 2d 765, a person not admitted to the Kansas Bar was ordered to cease and desist from the practice of law. The Court, among other things, had this to say about the importance to the courts and litigants of preserving the integrity of the Bar and prohibiting unauthorized practice:

"The importance to courts and litigants of well-informed trustworthy attorneys at law is well recognized, and frequently has been judicially noticed. Recently, in Re Opinion of the Justices, 279 Mass. 607, 180 N. E. 725, 727, 81 A. L. R. 1059 it was said: 'It is indispensable to the administration of justice and the interpretation of the laws that there be members of the bar of sufficient ability, adequate learning and sound moral character. This arises from the need of enlightened assistance

to the honest, and restraining authority over the knavish, litigant. It is highly important, also, that the public be protected from incompetent and vicious practitioners, whose opportunity for doing mischief is wide.'

"In Re Cannon, 206 Wis. 374, 240 N. W. 441, 445, it was said: 'The relation of the bar to the courts is a peculiar and intimate relationship. The bar is an attache of the courts. *The quality of justice dispensed by the courts depends in no small degree upon the integrity of its bar. An unfaithful bar may easily bring scandal and reproach to the administration of justice and bring the courts themselves in to disrepute.*'

"The opinion contains an exhaustive history of the development of the bar as an aid in the administration of justice.

"In Rosenthal v. State Bar Examining Committee, 116 Conn. 409, 165 A. 211, at page 213, it was said:

'The practice of law is not a craft or a trade; it is a profession whose main purpose is to aid in the doing of justice according to law between the state and the individual and between man and man. The occasions upon which an attorney may be required to act touch, in many instances, the deepest and most precious concerns of men, women, and children. They may involve the liberty, the property, the happiness, the character, and the life of his client. Obviously, one not possessing an adequate degree of intelligence and education cannot perform this kind of service, nor should he be permitted to attempt to do so. * * *

'The ultimate purpose of all regulations of the admission of attorneys is to assure the courts the assistance of advocates of ability, learning, and sound character and to protect the public from incompetent and dishonest practitioners.'" (Emphasis added)

In *Harter Title & Abstract Co. v. Grievance Committee* (1944), 142 Tex, 596, 179 S. W. 2d 946, *supra*, the Supreme Court of Texas also pointed out that it would be useless from the standpoint of the public interest to require high standards of the Bar if persons not members could practice the arts of the profession. The Court, among other things, said:

> "*The practice of law is a matter of vital interest to the public.* The lawyer is primarily engaged in the protection and preservation of the liberties and property rights of the people and the administration of justice among them, which is one of the primary purposes of good government. As society has become more compact the law has necessarily become more complex, requiring increased skill in its application. The Legislature in recognition of this fact has from time to time increased the prelegal and legal attainments required for admission to the Bar. These safeguards have been deemed necessary by the Legislature to protect the public against the loss of their liberty and property rights through ill advice from incompetent practitioners. It is readily apparent that it would serve no useful purpose to require high standards of efficiency for members of the legal profession if those who have not attained these standards of efficiency are to be permitted to practice the arts of the profession. Also, the relation between attorney and client is a most intimate one, involving the highest degree of confidence and trust, and in which, as a consequence, there is almost unlimited opportunity for fraud on the part of the attorney. It is apparent, therefore, that those who are to be entrusted with the opportunities of such a position should be possessed of a high degree of integrity. In recognition of this the Legislature has set up machinery for the establishment of canons of ethics for the profession, and the disbarment of those guilty of fraudulent or dishonorable practice or malpractice.

> *Again, it would be useless to establish high standards of morality for members of the profession if those who are not members, and therefore not bound by such canons, could practice the arts of the profession.* The State has a vital interest in the regulation of the practice of law for the benefit and protection of the people as a whole, and the legislation above referred to was adopted in furtherance of a wholesome public policy." (Emphasis Added) (pp. 947-8)

In *Clark* v. *Reardon* (1937), 231 Mo. App. 666, 104 S. W. 2d 407, *supra*, where a non-lawyer was adjudged in contempt of court for unlawfully practicing law, the Court, among other things, said:

> "This court has inherent powers to guard the administration of the law in its jurisdiction. That is the primary power. The regulation of attorneys is but secondary and supplemental. It is our duty to see that the law is administered by none except those deemed qualified, as evidenced by a license; and by them only as long as they remain ethically qualified. *It would be illogical* to say that we have the inherent power to revoke the license of, or to punish, one who was once deemed, by competent authority, to be fitted to advise the public in legal matters, and *also to hold that such inherent authority does not extend far enough to protect the public and the reputation of the law, the courts, and the ministers of the law and the courts, against one never considered qualified to advise in and practice the law.* 'To deny the power of the court to deal with such offenders would be tantamount to a destruction of the power itself.' People ex rel. Illinois State Bar Association et al v. People's Stock Yards State Bank, 344 Ill. 462, loc. cit. 473, 176 N. E. 901, 906; Clark et al v. P. H. Coon, supra." (p. 412) (Emphasis added)

In *State* v. *Barlow* (1936), 131 Neb. 294, 268 N. W. 95, where an information charging a non-lawyer with

the unlawful practice of law was sustained, the Court, among other things, said:

> "*This court possesses inherent power to protect itself and its officers from any unlawful interference with its functions as a court.* This it may do, not only for the purpose of protecting the court and its officers, but in the interest of the public at large to prevent it from being exploited and injured by one unlawfully assuming to act as an officer of the court. *There are many instances where persons' rights have been jeopardized and sacrificed because of following the counsel and advice of unlicensed persons, giving or attempting to give legal advice.*" (p. 98-99) (Emphasis added)

In *Grievance Committee, etc.* v. *Coryell* (Tex. Civ. App. 1945), 190 S. W. 2d 130, a notary public who was drawing real estate conveyances and giving opinions on titles was held to have been engaged in the unauthorized practice of law. The Court, among other things, said:

> "The controlling purpose of all laws, rules and decisions with regard to the licensing of lawyers is to protect the public against persons inexperienced and unlearned in legal matters from attempting to perform legal services. Wrong legal advice by a layman is equally injurious whether given for or without consideration or compensation. *The instances are legion where litigation could have been avoided and expense saved had the deed, mortgage, will, or contract involved been drawn by an attorney instead of a layman inexperienced and unlearned in the legal effect of the language used in such instruments.* The paramount purpose of licensing practitioners of law is the protection of the people from the inexperienced and unlearned in law who attempt to practice law without first qualifying themselves in the courses of study and as to the character require-

ments prescribed for lawyers. So, independently of any statutory provisions as to what may constitute practice of law, the court has the duty and the inherent power to determine in each case what constitutes the practice of the law and to inhibit persons from engaging in the practice of law without having obtained a license to do so." (Emphasis Added) (p. 131)

See also *People* v. *Lawyers Title Corp.* (1940), 282 N. Y. 513, 27 N. E. 2d 30, 33.

There are many cases showing injury to the public through the incompetence or other deficiencies of unauthorized practitioners in the real estate field.

In *In re Baker* (1951), 8 N. J. 321, 85 A. 2d 505, where non-lawyers were held to have unlawfully engaged in the practice of law by drafting legal instruments, Chief Justice Vanderbilt said:

> "We do not consider it to be necessary that a person be engaged in a 'course of conduct' over a period of time in order to be engaged in the practice of law. To impose such a test would result in the wholly absurd situation of this court being called upon to determine how many wills a layman may draw, or how many 'clients' he may advise, or, more bluntly, how many times he may defraud the public by his impositions before he be deemed to be engaged in the practice of law and thus subject to the superintending power of this court. We are of the firm opinion that a single act, e.g., the preparation of a will or the drawing of a power of attorney, may in appropriate circumstances constitute the practice of law. There is no sound reason why the doing of a single act calling for the skills and learning of an attorney does not constitute the practice of law just as most certainly the performance of a single operation by a surgeon constitutes the practice of medicine. *The amateur at law is as dangerous to the community*

as an amateur surgeon would be." (Emphasis added) (pp. 513-14)

"The soundness of his position is the more evident if it is borne in mind that the *underlying purpose of regulating the practice of law is not so much to protect the public from having to pay fees to unqualified legal advisors as it is to protect the public against the often drastic and far-reaching consequences of their inexpert legal advice.*" (Emphasis added) (p. 514)

CONCLUSION

Petitioner is no more entitled, by virtue of his "recognition" by the Patent Office, to practice law relating to patents in Florida—that is, outside the courtroom, in Florida—than he is to practice law relating to patents inside the courtroom, that is, in this Court and the other federal Courts, and in the United States Court of Customs and Patent Appeals.

The judgment should be affirmed.

Respectfully submitted,

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February 4, 1963

APPENDIX

Constitution of the United States

Art. I, Sec. 8, cl. 8. The Congress shall have power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

. . . . . .

Art. I, Sec. 8, cl. 18. The Congress shall have Power . . . To make all Laws which shall be necessary and proper for carrying into Execution the foregoing Powers, and all other Powers vested by this Constitution in the Government of the United States, or in any Department or Officer thereof.

. . . . . .

Art. VI, cl. 2. This Constitution, and the Laws of the United States which shall be made in Pursuance thereof and all treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, anything in the Constitution or Laws of any State to the contrary notwithstanding.

Amendment X. The powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people.

Constitution of the State of Florida

Art. II. The powers of the government of the State shall be divided into three departments: Legislative, Executive and Judicial. No person properly belonging to one of the departments shall exercise any powers appertaining to either of the other departments, except in cases expressly provided for by this constitution.

Art. V, § 1. The judicial power of the State of Florida is vested in a supreme court, district courts of appeal, circuit courts, Court of Record of Escambia County, criminal courts of record, county courts . . . and such other courts, including municipal courts, or commissions, as the Legislature may from time to time ordain and establish.

§ 23. The supreme court shall have exclusive jurisdiction over the admission to practice law and the discipline of persons admitted. . . .

Section 2, Article 2, of the Integration Rule of The Florida Bar, 31 F.S.A.:

"No person shall engage in any way in the practice of law in this state unless such person is an active member of The Florida Bar, in good standing, except that a practicing attorney of another state, in good standing, who has professional business in a court of record of this state may, upon motion, be permitted to practice for the purpose of such business only, when it is made to appear that he has associated and appearing with him in such business an active member of The Florida Bar."

Acts of Congress

(1) In effect when Petitioner was admitted to practice before the Patent Office in 1928:

Section 487 of the Revised Statutes, As Amended by § 3 of the Act of February 18, 1922, 42 Stat. 390, 35 U.S.C. § 11 (1946):

The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may prescribe rules and regulations governing the recognition of agents, attorneys, or other persons representing applicants or other parties before his office, and may require of such persons, agents, or attorneys, before being recognized as representatives of applicants or other persons, that they shall show that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and

are likewise competent to advise and assist applicants or other persons in the presentation or prosecution of their applications or other business before the office. And the Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before his office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the said rules and regulations, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the office, by word, circular, letter, or by advertising. The reasons for any such suspension or exclusion shall be duly recorded. And the action of the Commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the Supreme Court of the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine.

Section 483 of the Revised Statutes (As Amended by § 12 of the Act of February 14, 1903, 32 Stat. 830, 35 U.S.C. § 6 (last sentence) (1946):

The Commissioner of Patents may, subject to the approval of the Secretary of Commerce, from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

(2) Currently in effect:

35 U.S.C. §§ 31, 32, 33:

§ 31. The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

§ 32. The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney, shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded.

§ 33. Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

35 U.S.C. § 6 (last sentence):

The Commissioner of Patents may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, in the conduct of proceedings in the Patent Office.

Rules of Practice of the United States Patent Office in Patent Cases

(1) Rules of Practice, U. S. Patent Office, Edition of February 1, 1929:

ATTORNEYS

17. An applicant or an assignee of the entire interest may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent patent attorney, as the value of patents depends largely upon the skillful preparation of the specification and claims. The office can not aid in the selection of an attorney.

A register of attorneys will be kept in this office, on which will be entered the names of all persons entitled

to represent applicants before the Patent Office in the presentation and prosecution of applications for patent. The names of persons in the following classes will, upon their written request, be entered upon this register:

(*a*) Any attorney at law who is in good standing in any court of record in the United States or any of the States or Territories thereof and who shall furnish a certificate of the clerk of such United States, State, or Territorial court, duly authenticated under the seal of the court, that he is an attorney in good standing, and who shall file proof that he is possessed of the legal and technical qualifications enumerated in paragraph (*b*).

(*b*) Any person not an attorney at law who is a citizen or resident of the United States and who shall file proof to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the necessary legal and technical qualifications to enable him to render applicants for patents valuable service and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office.

* * * * * * * * * *

(*e*) The Commissioner may require proof of qualifications other than those specified in paragraph (*a*) and reserves the right to decline to recognize any attorney, agent, or other person applying for registration under this rule.

(*f*) Any person or firm not registered and not entitled to be recognized under this rule as an attorney or agent to represent applicants generally may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent certain specified application or applications, but this limited recognition shall not extend further than the application or applications named.

(*g*) No person not registered or entitled to recognition as above provided will be permitted to prosecute applications before the Patent Office.

(*h*) Every attorney registered to practice before the United States Patent Office shall submit to the Commissioner of Patents for approval copies of all proposed advertising matter, circulars, letters, cards, etc., intended to

solicit patent business, and if it be not disapproved by him and the attorney so notified within 10 days after submission, it may be considered approved.

Any registered attorney sending out or using any such matter, a copy of which has not been submitted to the Commissioner of Patents in accordance with this rule, or which has been disapproved by the Commissioner of Patents, shall be subject to suspension or disbarment.

Before his name may be entered on the Register of Attorneys every applicant must subscribe and swear to an oath prescribed by the Commissioner of Patents and pay to the Patent Office a registration fee of $5.

18. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate can not be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or of any of its members, unless all its members be named in such power of attorney.

19. Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second agent to appoint a third.

20. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the Commissioner; and when so revoked the office will communicate directly with the applicant, or another attorney appointed by him. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney. An assignment will not operate as a revocation of the power previously given, but the assignee of the entire interest may be represented by an attorney of his own selection.

21. Parties or their attorneys will be permitted to examine their cases in the attorneys' room, but not in the rooms of the examiners. Personal interviews with examiners will be permitted only as hereinbefore provided.

(See rule 13).

22. (*a*) Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and returned by his direct order.

(*b*) Complaints against examiners and other officers must be made in communications separate from other papers and will be promptly investigated.

(*c*) The Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before his office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the rules and regulations, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the office, by word, circular, letter, or by advertising, or who shall guarantee the successful prosecution of any application for patent or the procurement of any patent, or by word, circular, letter, or advertisement shall make any false promise or misleading representation, or who uses the name of any Member of either House of Congress or of any officer of the Government in advertising his business. (Act approved April 27, 1916.) The reasons for any such suspension or exclusion shall be duly recorded. And the action of the Commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the Supreme Court of the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine.

(*d*) The Commissioner of Patents may appoint a Grievance Committee or Grievance Committees of those admitted to practice before the Patent Office. The Commissioner may refer to such committee such complaints against those admitted to practice before the Patent Office as he deems advisable. The committee or a subcommittee thereof may investigate and determine whether the complaint is well founded and, if so, present charges for suspension or exclusion from practice.

(2) Current Rules of Practice, 37 C.F.R. §§ 1.31, 1.341—1.348:

§ 1.31. Applicants may be represented by an attorney or agent. An applicant for patent may file and prosecute his own case, or he may be represented by an attorney or agent authorized to practice before the Patent Office in patent cases. The Patent Office cannot aid in the selection of an attorney or agent.

§ 1.341. Registration of attorneys and agents. A register of attorneys and a register of agents are kept in the Patent Office on which are entered the names of all persons recognized as entitled to represent applicants before the Patent Office in the preparation and prosecution of applications for patent. **Registration in the Patent Office under the provisions of these rules shall only entitle the persons registered to practice before the Patent Office.**

(a) *Attorneys at law.* Any attorney at law in good standing admitted to practice before any United States Court or the highest court of any State or Territory of the United States who fulfills the requirements and complies with the provisions of these rules may be admitted to practice before the Patent Office and have his name entered on the register of attorneys.

(b) *Agents.* Any citizen of the United States not an attorney at law who fulfills the requirements and complies with the provisions of these rules may be admitted to practice before the Patent Office and have his name entered on the register of agents.

(c) *Requirements for registration.* No person will be admitted to practice and registered unless he shall apply to the Commissioner of Patents in writing on a prescribed form supplied by the Commissioner and furnish all requested information and material; and shall establish to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the legal and scientific and technical qualifications necessary to enable him to render applicants for patents valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office. In order that the Commissioner may determine whether a person seeking to

have his name placed upon either of the registers has the qualifications specified, satisfactory proof of good moral character and repute, and of sufficient basic training in scientific and technical matters must be submitted and an examination which is held from time to time must be taken and passed. The taking of an examination may be waived in the case of any person who has actively served for four years in the examining corps of the Patent Office.

(d) *Registration of firms.* Any firm, the individual members of which are each registered on the register of attorneys, may have its name entered upon the register of attorneys. Any firm, one of the individual members of which is registered on the register of agents and each of the remaining individual members are registered either on the register of attorneys or the register of agents, may have its name entered on the register of agents. If the membership of the firm is changed, application must be made for registration of the firm as changed.

(e) *Foreign patent attorneys and agents.* Any foreign patent attorney or agent not a resident of the United States who shall file proof to the satisfaction of the Commissioner that he is registered and in good standing before the patent office of the country in which he resides and practices, and is possessed of the qualifications stated in paragraph (*c*) of this rule, may be registered on the register of agents as entitled to represent applicants located in such country before the United States Patent Office in the presentation and prosecution of applications: *Provided*, That the patent office of such country allows substantially reciprocal privileges to those admitted to practice before the United States Patent Office. Such registration shall continue only during the period that the conditions specified obtain.

(f) *Government employees.* Officers and employees of the United States who are disqualified by statute (18 U.S.C. 281) from practicing as attorneys or agents in proceedings or other matters before Government departments or agencies, may not be registered, and if any registered attorney or agent becomes such an officer or employee, his name on the register shall be endorsed as inactive during the period of such employment, but officers or employees whose official duties require the preparation and prosecu-

tion of applications for patent may be registered (on compliance with these rules) or recognized to practice, to the extent necessary to carry out their official duties.

(g) *Former examiners.* No person who has served in the examining corps of the Patent Office will be registered after termination of his services, nor, if registered before such service, be reinstated, unless he undertakes (1) not to prosecute or aid in any manner in the prosecution of any application pending in any examining division in which he served, on the date he left said division; and (2) not to prepare or prosecute nor to assist in any manner in the preparation or prosecution of any application of another filed within two years after the date he left such division, and assigned to such division, without the specific authorization of the Commissioner. Associated and related classes in other divisions may be required to be included in the undertaking or designated classes may be excluded. In case application for registration or reinstatement is made after resignation from the Office, the applicant will not be registered, or reinstated, if he has prepared or prosecuted, or assisted in the preparation or prosecution of any such application as indicated in this paragraph.

(h) *Oath and registration fee.* Before his name may be entered on the register of attorneys or on the register of agents, every applicant for registration must, after his application is approved, subscribe and swear to an oath prescribed by the Commissioner of Patents and pay the prescribed registration fee. (See § 1.21.)

(i) *Committee on Enrollment.* The Commissioner may establish a Committee on Enrollment to receive and act upon applications for registration to practice before the Patent Office, to conduct and supervise the examinations provided for in paragraph (c) of this rule, to maintain the registers and to perform such other duties in connection with enrollment and recognition of attorneys and agents as may be necessary; or such functions may be performed by designated officials of the Patent Office. Any action of such committee or official may be reviewed by the Commissioner.

§ 1.342. Limited recognition. Any person not registered and not entitled to be recognized under § 1.341 as an attorney or agent to represent applicants generally may,

upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent a specified application or applications, but this limited recognition shall not extend further than the application or applications specified.

§ 1.343. Persons not registered or recognized. No person or firm not registered or specifically recognized as provided in § 1.342 will be permitted to prosecute applications of others before the Patent Office.

§ 1.344. Professional conduct. Attorneys and agents appearing before the Patent Office must conform to the standards of ethical and professional conduct generally applicable to attorneys before the courts of the United States.

§ 1.345. Advertising. (a) The use of advertising, circulars, letters, cards, and similar material to solicit patent business, directly or indirectly, is forbidden as unprofessional conduct, and any person engaging in such solicitation, or associated with or employed by others who so solicit, shall be refused recognition to practice before the Patent Office or may be suspended, excluded or disbarred from further practice.

(b) The use of simple professional letterheads, calling cards, or office signs, simple announcements necessitated by opening an office, change of association, or change of address, distributed to clients and friends, and insertion of listings in common form (not display) in a classified telephone or city directory, and listings and professional cards with biographical data in standard professional directories shall not be considered a violation of this rule.

(c) *No agent shall, in any material specified in paragraph (b) of this section or in papers filed in the Patent Office, represent himself to be an attorney, solicitor or lawyer.*

§ 1.346 Signature and certificate of attorney. Every paper filed by an attorney or agent representing an applicant or party to a proceeding in the Patent Office must bear the signature of such attorney or agent, except papers which are required to be signed by the applicant or party in person (such as the application itself and affidavits required of applicants). The signature of an attorney

or agent to a paper filed by him, or the filing or presentation of any paper by him, constitutes a certificate that the paper has been read; that its filing is authorized; that to the best of his knowledge, information, and belief there is good ground to support it; and that it is not interposed for delay. When an applicant or party is represented by a registered firm, such papers must carry the signature of the firm, or the signature of an individual member of the firm or an individual registered attorney or agent employed by the firm and duly authorized to sign on behalf of the firm in addition to the firm name, and the certification constituted by the signing or presentation of the paper shall be a certification by and on behalf of the firm and by the individual.

§ 1.347. Removing names from registers. Attorneys, agents, and firms, registered to practice before the Patent Office, should notify the Office of any change of address for entry on the register, by letter separate from any notice of change of address filed in individual applications. The Office may address a letter to any person or firm on the registers, at the address of which separate notice for the register was last received, for the purpose of ascertaining whether such person or firm desires to remain on the register. The name of any person or firm failing to reply and give the information requested within a time limit specified will be removed from the register, and the names so removed published in the Official Gazette. Any name so removed may be reinstated, either on the register of attorneys or the register of agents, as may be appropriate.

§ 1.348. Suspension or disbarment proceedings. Except as otherwise provided, proceedings for suspension, disbarment, or exclusion from practice are before a Commissioner.

(a) *Investigating and prosecuting officer.* The duties of investigation, preparing charges, collecting and presenting testimony, and presenting a case for suspension, exclusion from practice or disbarment shall be performed by the Solicitor of the Patent Office or, at his direction, by a designated law examiner or other person, and neither the Solicitor nor such law examiner or other person shall participate in any manner in the decision of the case. If, upon investigation of a complaint or other informa-

tion concerning an attorney or agent, it shall appear to the Solicitor that grounds for suspension, exclusion from practice, or disbarment exist, he shall prepare and forward the necessary notice and statement.

(b) *Notice of proceedings.* Proceedings for suspension or disbarment shall be instituted by the Solicitor by mailing to, or otherwise serving on, the respondent a notice of such proceeding with a statement of the charges against him, at the same time forwarding a copy to the Commissioner. It shall be the duty of the respondent to answer the charges as specified in paragraph (c) of this rule.

(c) *Answer.* The respondent's answer shall be filed in writing with the Commissioner within thirty days from the time the notice is served on the respondent, or within such extension of time as may be allowed by the Commissioner for good cause shown. The answer shall be under oath. Failure to answer within the time allowed will be taken as an admission of the charges. The respondent in his answer should specifically admit or deny every material allegation of fact in the statement of charges; every allegation not denied shall be deemed admitted, unless the respondent states that he has no knowledge thereof sufficient to form a belief, which statement shall be considered a denial. Any special matters of defense shall be stated affirmatively in the answer. False statements in the answer may be made the basis of supplemental charges.

(d) *Hearing.* (1) Unless the Commissioner finds the answer sufficient to dispose of the charges, he will set the case for hearing before him, notifying the respondent and the Solicitor of the place, day and time of commencement of the hearing. Evidence as to the matters in issue may be submitted at the hearing, the testimony of witnesses being presented orally, under oath and reported.

(2) The hearing may be advanced and continued by the Commissioner, as far as may be deemed convenient and proper.

(3) Depositions for use at the hearing in lieu of personal appearance of witnesses may be taken by either the Solicitor or the respondent on application to and with the written consent of the Commissioner within such times and under such conditions as the Commissioner may prescribe.

(e) *Hearing officer.* The Commissioner may, in his discretion, delegate the conduct of the hearing to a hearing or trial examiner who shall be the presiding officer and who shall make a recommended decision.

(f) *Administrative Procedure Act.* Proceedings shall be governed, in matters not specially set forth herein, by the provisions of the Administrative Procedure Act, 60 Stat. 237; 5 U.S.C. 1001-1011, which may be applicable. (Emphasis added.)

Current Trademark Rules of Practice of the U. S. Patent Office, 37 C.F.R. §§ 2.11—2.18:

REPRESENTATION BY ATTORNEYS AND AGENTS

AUTHORITY NOTE: Rules 2.11 to 2.19 interpret or apply 66 Stat. 705; 35 U.S.C. 31, 32.

2.11 *Applicants may be represented by an attorney.* The owner of a trademark may file and prosecute his own application for registration of such trademark, or he may be represented by an attorney or other person authorized to practice in trademark cases. The Patent Office cannot aid in the selection of an attorney or agent.

2.12 *Persons who may practice before the Patent Office in trademark cases.* (a) Any person who is a member in good standing of the bar of the Supreme Court of the United States or of the highest court of any State, Territory, or the District of Columbia, and is not under any order of any court suspending, enjoining, restraining, disbarring, or otherwise restricting him in the practice of law, may represent others before the Patent Office in trademark cases. No application for recognition to practice in trademark cases by attorneys at law is required.

(b) Nonlawyers: *Persons who are not attorneys at law* as specified in paragraph (a) of this section *are not recognized to practice before the Patent Office in trademark cases, except that persons not attorneys at law who were recognized to practice under the rules prior to January 1, 1959* (former rule 100.42), and who in fact practiced in *connection with applications for registration filed since* July 5, 1947, *will be recognized as agents to continue practice in trademark cases in the Patent Office.*

(c) Foreign attorneys and agents: Any foreign attorney or agent not a resident of the United States who shall file proof to the satisfaction of the Commissioner that he is

registered and in good standing before the patent or trademark office of the country in which he resides and practices, may be recognized to represent applicants located in such country before the United States Patent Office in the presentation and prosecution of trademark applications: *Provided*, That the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent Office. Such recognition shall continue only during the period that the conditions specified obtain.

(d) **Recognition of any person under this section is not to be construed as sanctioning or authorizing the performance of any acts regarded in the jurisdiction where performed as the unauthorized practice of law.**

(e) No persons other than those mentioned in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Patent Office in trademark cases. Any person may appear for himself, or for a firm of which he is a member, or for a corporation or association of which he is an officer and which he is authorized to represent, if such person, firm, corporation, or association is a party to the proceeding.

(f) Persons otherwise entitled to be recognized to practice under this section may, nevertheless, be refused recognition for cause.

2.13 *Professional conduct.* Attorneys and other persons appearing before the Patent Office in trademark cases must conform to the standards of ethical and professional conduct generally applicable to attorneys before the courts.

2.14 *Advertising.* (a) The use of display advertising, circulars, letters, cards, and similar material to solicit trademark business, directly or indirectly, is forbidden as unprofessional conduct, and any person engaging in such solicitation, or associated with or employed by others who so solicit, shall be refused recognition to practice before the Patent Office or suspended or excluded from further practice.

(b) The use of simple professional letterheads, calling cards, or office signs; simple announcements necessitated by opening an office, change of association, or change of address, distributed to clients and friends, and insertion of professional cards, listings in common form (not dis-

play) in a classified telephone or city directory, and listings and professional cards with biographical data in standard professional directories are not prohibited.

(c) *No agent shall, in any material specified in paragraph (b) of this section or in papers filed in the Patent Office, represent himself to be an attorney, solicitor or lawyer.*

2.15 *Signature and certificate of attorney or agent.* (a) Every paper filed by an attorney at law or other person representing an applicant or party to a proceeding in the Patent Office must bear the signature of such attorney at law or other person except those papers which are required to be signed by the applicant or party (such as the application itself and verifications required of applicants, registrant or others). The signature of an attorney at law or such other person to a paper filed by him, or the filing of any paper by him, constitutes a certificate that the paper has been read; that its filing is authorized; that to the best of his knowledge, information, and belief there is good ground to support it; and that it is not interposed for delay.

(b) When an applicant or party is represented by a firm composed of attorneys at law, papers may carry the signature or name of the firm, with the signature of a member or associate of the firm.

(c) When an applicant or party is represented by a firm (registered in accordance with rule 1.341 (d) of this chapter) which includes one or more nonlawyers, papers may carry the signature or name of the firm, but in any case, they must carry the signature of an individual member of the firm or of an individual employee of the firm who is registered in the Patent Office and who is authorized to sign on behalf of the firm, the certification referred to in paragraph (a) of this section shall, in either case, be a certification by and on behalf of the firm and by the individual.

2.16 *Suspension or exclusion from practice.* The Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office any person, attorney, or agent shown to be incompetent or disreputable, or guilty of unethical or unprofessional conduct or gross misconduct, or who refuses to comply with the rules and regulations, or who shall, with intent to

defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant or other person having immediate or prospective business before the Patent Office, by word, circular, letter, or in any other manner. The reasons for any such suspension or exclusion shall be duly recorded. Proceedings for suspension, disbarment or exclusion from practice are conducted as provided in rule 1.348. (See 35 U. S. C. 1952, sec. 32 for review of the Commissioner's action by the District Court of the United States for the District of Columbia.)

2.17 *Recognition for representation.* (a) When an attorney at law acting in a representative capacity appears in person or signs a paper in practice before the Patent Office in a trademark case, his personal appearance or signature shall constitute a representation to the Patent Office that under the provisions of these rules and the law he is authorized, and qualified under rule 2.12 (a), to represent the particular party in whose behalf he acts. Further proof of authority to act in a representative capacity may be required.

(b) Before any nonlawyer will be allowed to take action of any kind in any application or proceeding, a written authorization from the applicant, party to the proceeding, or other person entitled to prosecute such application or proceeding must be filed therein.

2.18 *Correspondence held with attorney or agent.* Correspondence will be held with the attorney at law, or other recognized person who shall have filed his written authorization, representing the applicant or party to a proceeding. Double correspondence will not be undertaken, and if more than one attorney at law appears or more than one agent is authorized, correspondence will be held with the one last appearing or appointed, as the case may be, unless otherwise requested.

2.19 *Revocation of power of attorney or authorization of agent.* Authority to represent an applicant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon notification to the Commissioner; and when it is so revoked, the Office will communicate directly with the applicant or party to the proceeding or with such other qualified person as may be authorized. The Patent Office will notify the person affected of the revocation of his authorization. (Emphasis added.)